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Application/Patent No: 09/756,788

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Inventor/Title: MICHAEL C. SCROGGIE ET AL./System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: JANVIER/3688

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 APPEAL BRIEF

Sir:

In response to the non-final office action mailed September 17, 2008 and further to the amendment filed September 29, 2008 in response to the non-final office action, the applicant files this appeal. An appeal was previously filed in this case, but did not result in a decision because the examiner reopened prosecution.

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I. 37 CFR 41.37 (a)(1) and (2) - Notice Of Appeal, Brief, and Fees

This brief sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

On March 15, 2004, the applicant (1) filed a Notice of Appeal and an Appeal Brief under 37 CFR 1.192 and (2) paid the \$660 fee for a notice of appeal and for an appeal brief as set forth in 37 CFR 1.17(b) and 37 CFR 1.17(c). The current fee for filing a notice of appeal and an appeal brief is \$540 for each, or \$1080 total. The \$420 difference is submitted herewith by USPTO deposit account authorization. No additional fees are due.

II. 37 CFR 41.37(b) - Dismissal of Appeal if Brief and Fees Untimely

The filing is timely. Accordingly, this subsection is not relevant.

III. 37 CFR 41.37(c)(1)

The brief contains items (i) to (x) of this subsection.

A. 37 CFR 41.37(c)(1)(i) Real Party in Interest

The real party in interest is Catalina Marketing Corporation, a Delaware corporation.

B. 37 CFR 41.37(c)(1)(ii) Related Appeals and Interferences

The following applications or patents have the same disclosure (CAT/29US series) as the application being appealed.

1. CAT/29US-SCRCO2; 09/756,787; pending
2. CAT/29US-SCRCO4; 11/449,596; abandoned
3. CAT/29US-SCRO; 08/905,501; 6,014,634; reexamination 90/005,888; abandoned
4. CAT/29US-SCROCO; 09/401,939; pending
5. CAT/29US-SCROD1; 09/401,198; abandoned
6. CAT/29US-SCROD2; 09/410,086; pending

The following applications or patents have less than the entire disclosure (CAT/29 series), lacking therein Figs. 16-18 and the description thereof in the application being appealed.

7. CAT/29-SCRO; 08/622,685; 5,970,469
8. CAT/29-SCRO-CO; 09/310,382; 6,185,541

9. CAT/29-SCRO-CO2; 09/478,351; pending
10. CAT/29-SCRO-CO3; 09/567,274; abandoned
11. CAT/29-SCROCO4; 09/716,404; 6,885,994
12. CAT/29-SCROCO5; 11/019,217; 7,233,913

The following subsections 1-12 identify any related proceeding, and identify attachments for decisions from those related proceedings, for the applications identified above.

1. CAT/29US-SCRCO2; 09/756,787; pending
Status of appeal: BPAI Appeal No. 2007-4321.
2. CAT/29US-SCRCO4; 11/449,596; abandoned.
3. CAT/29US-SCRO; 08/905,501;

Status: Issued as U.S. Patent 6,014,634; reexamination 90/005,888, abandoned.

A copy of the BPAI Dismissal Order in Appeal 2006-1585, reexamination 90/005,888 (attorney docket number SCROREX634) mailed July 27, 2006 is Appendix III - Related Proceedings 9.

A copy of Dismissal Order 2008-1491 dated July 29, 2008 is Appendix III - Related Proceedings 12.

4. CAT/29US-SCROCO; 09/401,939; pending
Status of appeal: Appeal Number 2008-4478 docketed July 11, 2008.

A copy of the BPAI Decision on Appeal November 22, 2004 is Appendix III - Related Proceedings 2.

A copy of the BPAI Decision on Request for Rehearing March 14, 2005 is Appendix III - Related Proceedings 5.

A copy of the BPAI Decision on Petition July 18, 2008 is Appendix III - Related Proceedings 11.

5. CAT/29US-SCROD1; 09/401,198; abandoned

A copy of the BPAI Decision on Appeal November 30, 2004 is Appendix III - Related Proceedings 3.

A copy of the BPAI Decision on Request for Rehearing for Appeal November 30, 2004, mailed February 10, 2005 is Appendix III - Related Proceedings 6.

A copy of the CAFC Decision March 13, 2006 is Appendix III - Related Proceedings

8.

6. CAT/29US-SCROD2; 09/410,086; pending
BPAI order returning undocketed appeal to examiner July 25, 2006.
7. CAT/29-SCRO; 08/622,685;
Status: Issued as U.S. Patent 5,970,469
8. CAT/29-SCRO-CO; 09/310,382;
Status: Issued as U.S. Patent 6,185,541
9. CAT/29-SCRO-CO2; 09/478,351;
Status: pending
BPAI order returning undocketed appeal to examiner August 21, 2008.
10. CAT/29-SCRO-CO3; 09/567,274;
Status: abandoned.

**A copy of the CAFC Appeal Docket No 05-1353; decision dated February 10, 2006
affirmance, per curium is Appendix III - Related Proceedings 7.**

**A copy of the BPAI decision on reconsideration mailed January 31, 2005 is
Appendix III - Related Proceedings 4.**

**A copy of BPAI decision on appeal mailed August 18, 2004 is Appendix III - Related
Proceedings 1.**

11. CAT/29-SCROCO4; 09/716,404;
Status: issued as U.S. Patent 6,885,994
12. CAT/29-SCROCO5; 11/019,217;
Status: Issued as U.S. Patent 7,233,913.

**C. 37 CFR 41.37 (c)(1)(iii) -Status of claims. A statement of the status of all the
claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn,
objected to, canceled) and an identification of those claims that are being
appealed**

Claims 1-31 are cancelled. Claims 32-97 are pending.

Claims 32-91 are rejected. Claims 92-97 are new, are not rejected, and are not allowed.

Claims 32-97 are being appealed.

D. 37 CFR 41.37(c)(1)(iv) Status of Amendments Filed Subsequent to Final Rejection

There are no amendments filed subsequent to final rejection.

E. 37 CFR 41.37(c)(1)(v) Summary of Claimed Subject Matter

Claim 32 defines a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 3 lines 12-16, page 18 lines 27-29; figure 13, element 306); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1; figure 15, element 502); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3; figure 9, 90), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1; figure 15, elements 506, 508, 512); and means for delivering purchasing incentives to consumers by e-mail (page 20 lines 17-19; figure 15, element 514).

Claim 38 defines a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29; figure 13, element 306); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1; figure 15, element 502, 506, 508); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3; figure 9, element 90), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1; figure 15, elements 506, 508, 512); and a means for delivering by e-mail notices which remind consumers to visit said Web site (page 20 lines 17-19 and page 21 lines 25-27; figure 15, element 514).

Claim 44 defines a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29; figure 13, element 306); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1; figure 15,

elements 502, 506, 508); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3; figure 9, elements 90), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1; figure 15, elements 506, 508, 512); and means for delivering by e-mail notices to purchase a specific manufacturer's product (page 20 lines 17-19; figure 15, elements 514).

Claim 50 defines a method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources (page 18 lines 21-29; figure 13, elements 306); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1; figure 15, elements 502, 506, 508); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3; figure 15, elements 508, 510, 512); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3; figure 9, elements 90); and transmitting purchase incentives via an e-mail post office (page 21 lines 4-8; figure 15, element 516).

Claim 54 defines a method for delivering incentives over the Internet comprising the steps of: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29; figure 13, elements 306); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1; figure 15, elements 502, 506, 508); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3; figure 15, elements 510, 512); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3; figure 9, elements 90); and transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office (page 21 lines 25-27; figure 15, elements 516).

Claim 57 defines a Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising: a personal database (page 22 lines 11-12; figure 16, elements 604, 606); a purchase history database wherein the data on the consumer purchases are based on online shopping activity (page 23 lines 6-16, page 22 lines 10-

17, and page 20 line 25 through page 21 line 1; figure 15, elements 502, 506, 508); means for generating a web page with a consumer-specific display (page 22 lines 16-18; figure 16, elements 606, 610); means for updating said web page (page 20 lines 12-14 and page 23 lines 12-14; figure 17, 624); and means for informing the consumer by e-mail of new incentives (page 20 lines 2-4; figure 17, element 626).

Claim 58 defines a method for delivery of incentives by e-mail, comprising the steps of: maintaining a consumer database which identifies consumers by their e-mail addresses; generating targeted purchase incentives from a consumer purchase history database; and formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon; and delivering the email message to an email address stored in said consumer database for said consumer (page 21 lines 4-9; figure 15, elements 502, 504, 506, 508, 510, 512, 514, 516).

F. 37 CFR 41.37(c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal

Whether the rejections of claims 31 [sic; 32], 38, 44, 50, 54, and 57 under the second paragraph of 35 USC 112 are improper and should be reversed.

Whether the rejection of claim 57 under 35 USC 101 is improper and should be reversed.

Whether the rejections of claims 32-91 under 35 USC 103(a) as being unpatentable over Barnett, US Patent 6,321,208 (hereinafter “Barnett”) in view of Shane, US Patent 5,793,972 (hereinafter “Shane”) are improper and should be reversed.

G. 37 CFR 41.37(c)(1)(vii) Argument

Reasoning relating to the three grounds of rejection for review appear in the following three sections.

IV. WHETHER THE REJECTIONS OF CLAIMS 31 [SIC; 32], 38, 44, 50, 54, AND 57 UNDER THE SECOND PARAGRAPH OF 35 USC 112 ARE IMPROPER AND SHOULD BE REVERSED

A. The Recitation "a consumer database which *can* identify consumers by their e-mail addresses"

The office action indicates that claims 31 [sic; 32], 38, 44, 50, 54, and 57 are rejected because they recite the word "can" "which creates some uncertainty." Office action mailed September 17, 2008 page 4 lines 3-5.

Claim 32 read:

32. (Previously Presented) A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which *can identify consumers by their e-mail addresses*, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering purchasing incentives to consumers by e-mail.

Claim 32 clearly indicates that the consumer database stores consumer email addresses. Claim 32 was drafted in the foregoing form to follow closely the language of the specification, page 20 lines 27. Thus, the applicant disagrees with the examiner that claim 32 is indefinite in this respect (and that fact is supported by the objective evidence that no examiner has previously rejected claim 32 in this regard despite repeated appeal filings in this application over several years). However, in order to moot the issue, in response to the office action mailed September 17, 2008, the applicant amended claim 32 as follows.

32. (Currently amended) A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~, wherein said consumer database is

connected to said Web site so as to receive consumer data from said Web site;
and

means for delivering purchasing incentives to consumers by e-mail.

Claims 32, 38, 44, 50, and 54 contained the foregoing or a similar recitation and were all amended accordingly.

B. The Recitation "A Web site"

The office action states that claim 57 is indefinite because it recites "a web site or data per se in the preamble, while the body of the claim contains structure or means plus function." Office action mailed September 17, 2008 page 4 lines 63-8

Claim 57 reads as follows:

57. (Previously Presented) A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:
a personal database;
a purchase history database wherein the data on the consumer purchases are based on online shopping activity;
means for generating a web page with a consumer-specific display;
means for updating said web page; and
means for informing the consumer by e-mail of new incentives.

In reply, the rejection of claim 57 is improper and should be withdrawn for the following reasons. First, the preamble does not recite "data per se". It recites a "Web site". The conventional definition of a Web site is:

noun: a computer connected to the internet that maintains a series of web pages on the World Wide Web ("The Israeli web site was damaged by hostile hackers").

See the definition from "One Look" at <http://www.onelook.com/?w=Web+site&ls=a> A

copy of <http://www.onelook.com/?w=Web+site&ls=a> is included herewith as Evidence Appendix Attachment 1. This evidence was originally submitted in the response to the non final office action mailed September 17, 2008.

Similarly, the first definition in the list of computer category definitions on Evidence Appendix Attachment 1 (NetLingo) explains that:

The main difference between a Web site and traditional media is that a Web site is on a computer network (the Internet) and is coded in such a way that allows users to interact with it. Once you're on a site, you can make purchases, do searches, send messages, and other interactive activities

See the definition for Web Site from Netlingo at:

<http://www.netlingo.com/lookup.cfm?term=Web%20site> A copy of <http://www.netlingo.com/lookup.cfm?term=Web%20site> is included herewith as Evidence Appendix Attachment 2. This evidence was originally submitted in the response to the non final office action mailed September 17, 2008.

A computer network that is "coded in such a way that allows users to interact with it" is not data per se. Therefore, claim 57 does not recite "data per se in the preamble." Instead, it recites a "Web site" in the preamble, and it recites structure of a computer network forming part of the Web site, in the body of the claim. Therefore, the preamble and the body of claim 57 are consistent. Therefore, the rejection of claim 57 is improper.

V. WHETHER THE REJECTION OF CLAIM 57 UNDER 35 USC 101 IS IMPROPER AND SHOULD BE REVERSED

A. The Examiner's Argument

The office action rejects claim 57 under 35 USC 101 on the theory that a "web site is a collection of web pages, i.e., data per se." Office action mailed September 17, 2008 from page 3 lines 10-17.

B. The Appellant's Response

In response, the rejection is improper because a Web site is not data per se for the reasons and supporting evidence presented in discussion of the rejection of claim 57 as indefinite. Therefore, the rejection should be withdrawn.

Moreover, the rejection is improper because the body of claim 57 recites elements of a computer system which is also clearly statutory subject matter.

VI. WHETHER THE REJECTIONS OF CLAIMS 32-91 UNDER 35 USC 103(A) AS BEING UNPATENTABLE OVER BARNETT, US PATENT 6,321,208 (HEREINAFTER “BARNETT”) IN VIEW OF SHANE, US PATENT 5,793,972 (HEREINAFTER “SHANE”) ARE IMPROPER AND SHOULD BE REVERSED

A. The Examiner's Argument

In the office action mailed September 17, 2008 from page 5 line 3 through page 30 line 20, the examiner presents arguments rejecting claims 32-91 under 35 USC 103(a).

B. The Examiner has not Made a Prima Facie Case

The Patent and Trademark Office has the burden of showing a prima facie case of obviousness. In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993); In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

MPEP 706.02(j) specifies the required contents of a 35 USC 103 rejection, stating that they are to identify:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

In the office action mailed September 17, 2008, the examiner has failed to set forth: (B) the difference or differences in the claim over the applied reference(s). The office action does not correlate teachings in the prior art to claimed limitations. The examiner makes assertions regarding the disclosure or teachings in the prior art without reference to the claim language to which the examiner believes those prior art teachings are relevant. As such, the applicant finds it difficult to determine the basis for the rejections in many respects.

The applicant respectfully requests the BPAI to remand to the examiner to comply with item (B). That is, to order the examiner to clarify the record by expressly identifying the claim recitation and claim to which each cited prior art teaching pertains. Alternatively, the BPAI panel may decide to reverse the examiner for failing to specify a prima facie case.

Nevertheless, the appellant responds below to what the appellant believes to be the basis stated in the office action. To the extent that the examiner argues otherwise, such arguments should be specified as new grounds of rejection to afford the appellant to respond to the thrust of the rejection. See the following case law regarding what constitutes a new ground of rejection:

Appellants urge that the ultimate criterion of whether a rejection is considered "new" in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection. We agree with this general proposition, for otherwise appellants could be deprived of the administrative due process rights established by 37 CFR 1.196(b) of the Patent and Trademark Office. [In re Kronig, 539 F.2d 1300, 1303, 1976 CCPA LEXIS 140; 190 USPQ 425, ___ (CCPA 1976).]

The criterion of whether a rejection is considered "new" in a decision by the Board is whether appellants have had fair opportunity to react to the thrust of the rejection. In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). [Ex parte Werner K. Maas and Carlton L. Gyles, 1987 Pat. App. LEXIS 18; 9 USPQ2d 1746; 14 USPQ2d 1762 (BPAI 1987).]

Because our rationale for sustaining the rejections of claim 30, and claims

31 through 35 which stand or fall therewith, differs from that advanced by the examiner, we hereby designate our action in this regard as a new ground of rejection under 37 CFR § 1.196(b) in order to afford the appellant a fair opportunity to react thereto. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). [Ex parte Bollinger, Appeal No. 2004-0106 Application 09/907,974, 2001 Pat. App. LEXIS 112, 8 (BPAI November 22, 2001).]

Given its brevity we reproduce the examiner's statement of the rejection in full: 'Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by 5,962,533 [Bergeron]....' *** In this regard, we note that the examiner fails to identify any portion of Bergeron that describes a composition-comprising compound 33 or 34. *** We find no evidence on this record that the composition of Bergeron does not necessarily or inherently possess the characteristics of appellant's claimed [*10] composition. Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Bergeron. Claims 2-7 fall together with claim 1. However, since our basis for affirming the rejection differs from the examiner's, we designate the affirmance as a new ground of rejection under 37 CFR § 1.196(b) in order to provide appellant with a fair opportunity to respond. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). [Ex parte Bergeron, Appeal No. 2004-1008 Application No. 10/091,591, 2002 Pat. App. LEXIS 299, (BPAI February 1, 2002).]

**C. Summary of Reasoning Why the Prior Art Does Not Suggest the Invention;
Why the Examiner Erred**

In summary, for the reasons presented below, the rejection of amended claim 32 is improper.

First, the examiner errs in concluding claim 32's recitation of two separate databases would have been legally obvious in view of Barnett's single database.

Second, nothing in the prior art would have suggested the newly added limitation in

claim 32 ", wherein said consumer purchase history database stores in association with an identification of a consumer identification all items selected and purchased during a transaction by said consumer;".

D. **Claim 32**

Claim 32 read:

32. (Previously Presented) A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity;
a consumer database which *can identify consumers by their e-mail addresses*, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering purchasing incentives to consumers by e-mail.
The office action rejects all claims as obvious based upon Barnett and Shane.

E. **Review of Claim 32 and the Applied Prior Art**

1. **"A system for delivering incentives over the Internet"**

At page 5, the examiner asserts that Barnett discloses " A system for delivering incentives over the Internet". The applicant agrees.

2. **"A Web site for providing purchasing incentives from multiple sources;"**

At page 5, the examiner asserts that Barnett discloses " a Web site for providing purchasing incentives from multiple sources;". The applicant agrees.

3. **"a consumer purchase history database based on consumer online shopping activity;"**

At page 5, the examiner asserts that Barnett discloses "a consumer purchase history database based on consumer online shopping activity;" The examiner refers to Barnett's consumer database file 42, user's buying history profile, and the user's demographic data. Page 5, bottom half.

In reply, the applicant does not follow the examiner's reasoning. However, Barnett does disclose a coupon containing a code unique to each user and also encoding a product identification associated with the coupon, and logging consumer identification and product identification contained in the coupon when the coupon is redeemed by purchase of the identified product. Thus, Barnett discloses a system storing in a database a user identification in association with identification of a product for which the corresponding user redeemed a coupon. See Barnett column 7 lines 21-34 which explains that each coupon encodes not just a product identification but also a unique consumer identification. See Barnett column 7 lines 36-41 which explains that it is the product and consumer identification data for the coupons that were redeemed that the redemption center receives from the retail store in which a coupon is redeemed. See Barnett column 7 lines 45-55 which explains that the coupon distribution center receives the coupon redemption information, so called "user specific redemption data" and demographic data, that the coupon distribution center uses for marketing analysis. Notably absent is any conception of association of all product identification data associated with a purchase being stored in association with a consumer identification received during the purchase, transmission of that data to the coupon distribution center, and use of that transaction data by the coupon distribution center uses for marketing analysis.

In contrast, this application discloses that a purchase history database includes identification of all products associated in a transaction with a customer identification provided during the purchase transaction. See the following passages from the specification.

Each customer's purchasing behavior is tracked *only if the customer provides some form of unique identification during the purchase transactions*, such as a check-cashing card, a credit card, a magnetically encoded check, or other form of identification. The *purchase of any of a number of selected items can then be associated with a specific customer id.*, as indicated in block 404, and

a system administrator maintains a database of *customer purchase histories*, as indicated in block 406. [Page 19 lines 19-25.]

Delivery of Incentives by E-mail:

As shown in FIG. 15, the system of the invention also has the capability to deliver targeted or untargeted incentives to consumers through their online E-mail addresses on the Internet or another computer network. Retail stores, indicated by block 20 500, gather purchase data and either the retailers or an independent system administrator *accumulates the consumer purchase history in a database*, indicated at 502. *The database 502 is developed as a result of consumers being uniquely identified on each visit to the store, by use of a frequent shopper card, a credit card or some other form of identification.* [Page 20 lines 16-24.]

The consumer purchase history 502, which was discussed with reference to FIG. 15, is generated and updated from various sources pertaining to the shopping activities of all *identifiable consumers*. *In-store loyalty programs* based on past purchasing activity are one source of such data. Any online shopping activity is another source. [Page 23 lines 6-10.]

maintaining a consumer purchase history database derived in part from accumulated purchase data of identifiable consumers; [Original claim 24.]

In view of the foregoing, the applicant further amends claim 32 to clarify the claimed consumer purchase history database as follows.

32. (Currently amended) A system for delivering incentives over the Internet comprising:

- a Web site for providing purchasing incentives from multiple sources;
- a consumer purchase history database based on consumer online shopping activity, wherein said consumer purchase history database stores in association

with an identification of a consumer identification all items selected and purchased during a transaction by said consumer;

a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

As noted above, Barnett does not disclose a system in which a database stores "in association with an identification of a consumer identification all items selected and purchased during a transaction by said consumer". Barnett's system is incapable of that function because it receives only coupon redemption data.

Claims 32, 38, 44, 50, 54, 57, and 58, have been amended in a similar fashion to distinguish in this respect over Barnett.

Moreover, new dependent claims 92-97 depend from the independent claims and each recite "wherein at least one of said items was not the subject of a redeemed purchase incentive." Negative limitations of this kind are acceptable under the doctrines of inherency and so long as they do not introduce new concepts. See Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998)(" In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure. See Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).") In this application, the specification teaches that the natural result flowing from the disclosed method is a database record which includes in association with a customer identification, identification of all items purchased during a transaction, and that purchase incentives are provided for only some products. Therefore, it is inherent that not all product identifications stored in the database are for products for which a coupon was redeemed. Therefore, new dependent claims 92-97 are supported by the disclosure.

Moreover, claims 92-97 have written descriptive support for the same reasons expressed in the BPAI decision in Ex parte Franks, Appeal No. 2005-0847 (BPAI 9/26/2005), application

No. 09/939,689, wherein the panel reasoned that once the applicant provides written description for a genus, written description exists for the genus less one anticipatory condition contained in the prior art. A copy of Ex parte Franks, Appeal No. 2005-0847 (BPAI 9/26/2005 is included herewith as Evidence Appendix Attachment 3. (This evidence was originally submitted in this application in the response to the non final office action mailed September 17, 2008.) Specifically, in the panel decision in Appeal No. 2005-0847, a claim at issue was claim 39, which read as follows:

39. A composition which is storage-stable at 20° C, comprising:
- (1) a carrier substance which is water-soluble or water-swellaable and is in a glassy state;
 - (2) at least one material to be stored which is dissolved in said carrier substance;
 - wherein said composition exists in a glassy state at 20° C;
 - wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;
 - wherein said purified biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto;
 - wherein said composition contains no more than 4 percent by weight of water; and
 - wherein said biologically active material is not rennin.*

Decision page 2. There, the examiner's rejected for lack of written description

asserting "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 21, 31, 37, 39, and 41 ." See *id.*, at pages 3-4.

According to the examiner (Answer, page 4), "[rennin is not mentioned in

the disclosure, and silence in the specification is not support for a negative claim limitation." Accordingly, the examiner finds (Answer, page 4), "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 39 and 41." In support of this rejection, the examiner relies on Ex Parte Grasselli, 231 USPQ 339, aff'd on reh'g, 231 USPQ 395 (Bd. Pat. App. & Int. 1983).

In response, appellants admit (Brief, page 1 I), "the specification of this application does not mention rennin." According to appellant, the claims "specifically exclude[] rennin only because of the reference to rennin in the Shah reference." Appellants assert, however, "that [this] does not mean that the applicant's [sic] were not in possession of the genus of the inventions claimed by claims 39 and 41, either including or excluding rennin." According to appellants (Brief, bridging paragraph, pages 11-12),

there is no rational basis for a rule of law precluding negative limitations that exclude a species anticipating a generic claim when the reference does not teach the generic utility of the claimed invention. That is the case here. To the extent case law is inconsistent with this reasoning, it should be overruled....

Decision page 12. With those issues in mind, the panel held that:

We find the facts on this record to be substantially similar to those in In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). In Johnson, appellants narrowed their claims to avoid having them read on a lost interference count. On this record, appellants narrowed their claims to avoid having them read on the prior art. As set forth in Johnson, at 1019, 194 USPQ

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species there within, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of

those species, and has thus failed to satisfy the requirements of 31 12, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

The examiner failed to explain why after disclosing the genus - proteins, the subgenus - enzymes, and specifically describing several enzymes within the subgenus, that appellants have not described a composition as set forth in claims 39 and 41, wherein the biologically active material is not rennin. In our opinion, having described the whole, appellants have necessarily described the part remaining. Cf. id.

Accordingly, we reverse the rejection of claims 39 and 41 under 35 U.S.C. 112, first paragraph.

Decision at 13 and 14.

Like in Franks, the applicant here discloses the genus of saving all product identifications for products purchased during a transaction in association with a customer identification presented during that transaction.

Like in Franks, the application therefore has written description support for saving product identifications for products purchased during a transaction that are not associated with coupon redemptions.

4. **"a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~", wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and"**

1. **The Claimed Database Storing Email Addresses**

At page 6, the examiner asserts that Barnett discloses claim 32's " a consumer database which stores e-mail addresses of consumers ~~can identify consumers by their e-mail addresses~~". That is, the examiner asserts that Barnett discloses a database storing email addresses of consumers. That statement is incorrect. Barnett contains only one reference to email. That sole

reference in Barnett to email appears in the following passage:

In a further alternative embodiment of the present invention, the functions of the online service provider 2 are carried out at a site on the Internet. That is, a user may access the coupon data repository by accessing an appropriate Internet site. In this embodiment, the downloaded coupon management routines are encoded with a unique user identification number, which may be for example the user's email Internet address. When the user requests coupon data packages to be transmitted, the user identification number is encrypted and sent to the Internet site along with the request. Appropriate routines are implemented at the Internet site to decrypt the user's identification number and compare it against a list of valid members in order to ensure the validity of the user.

Barnett discloses a database storing a *"unique user identification number,"* not an email address. What Barnett states is that the value of the data stored in a field identified as *"unique user identification number,"* - - " may be for example the user's email Internet address." merely provides an example of a data value. Barnett provides no relevance to the *"unique user identification number,"* which would otherwise suggest that the user's email Internet address is what is stored in all records for all users in the *"unique user identification number"* field. Barnett provides no suggestion that data stored in the field for *"unique user identification number,"* for all users is an email address. Barnett discloses that the sole purpose of the *"unique user identification number,"* is to identify the user of the coupon is the user to whom the coupon was provided. Since any *"unique user identification number"* will serve that purpose Barnett teaches that the value of the *"unique user identification number"* is irrelevant. Therefore, nothing in Barnett suggests a database field storing email addresses of consumers.

In contrast, claim 32 recites "a consumer database which stores e-mail addresses of consumers." It is well understood in the database arts that a database that stores data "of" a particular type means that the schema of the database includes field identifications identifying that type. In this case the recitation "email address of consumers" means that the database contains one or more fields identified as "email addresses" in records associated with a consumer

identification. Barnett does not disclose or suggest that concept.

5. The Claimed Two Databases

At page 7, the examiner admits that Barnett fails to disclose claim 32's claimed two databases, the claimed "consumer purchase history database" and the claimed "consumer database". Specifically, the examiner statement at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively and to give respective users and/or operators access rights to the stored information." establishes that the examiner considered the two database files recitation, a limitation, and yet the office action does not assert that Barnett discloses that limitation. Cf. Federal Rule of Evidence 801(d)(2)(E) ("(B) Under established principles an admission may be made by adopting or acquiescing in the statement of another. While knowledge of contents would ordinarily be essential, this is not inevitably so: "X is a reliable person and knows what he is talking about." See McCormick § 246, p. 527, n. 15. Adoption or acquiescence may be manifested in any appropriate manner. When silence is relied upon, the theory is that the person would, under the circumstances, protest the statement made in his presence, if untrue. The decision in each case calls for an evaluation in terms of probable human behavior. In civil cases, the results have generally been satisfactory. In criminal cases, however, troublesome questions have been raised by decisions holding that failure to deny is an admission: the inference is a fairly weak one, to begin with; silence may be motivated by advice of counsel or realization that "anything you say may be used against you"; unusual opportunity is afforded to manufacture evidence; and encroachment upon the privilege against self-incrimination seems inescapably to be involved. However, recent decisions of the Supreme Court relating to custodial interrogation and the right to counsel appear to resolve these difficulties. Hence the rule contains no special provisions concerning failure to deny in criminal cases."). The examiner's failure to assert Barnett discloses two database files and then relying upon the alternative theory at page 7 that "it is common practice in the art to store different type of information in different and separate databases (database files) respectively" to suggest the claimed database structure is an admission that the examiner does not believe that Barnett discloses the claimed two database files. Moreover, for the reasons previously presented the applicant also does not believe that Barnett

discloses, or suggest, the claimed two database files.

At page 7, the examiner states that an "integrated database file 42 of fig. 6 or into two separate database files respectively is a matter of desires or choice, which does not impact the functionality or utility of the method or system." This is an admission that the examiner does not recognize the utility of two separate database files, which is probative of the fact that one of ordinary skill in the art would not recognize the value of two separate database files, and therefore is probative of the fact that there is no motivation to modify what Barnett and Shane disclose to be what claim 32 defines.

The examiner's conclusion that there is no utility to having two separate database files, as claimed, is incorrect. In this regard, the specification is relevant. The specification states at page 9 lines 24-26 that "the consumer 25 will be required to *enter a valid Internet address for electronic mail (E-mail), and to select a supermarket in his or her area*, as indicated in block 42." and at page 20 lines 9-14 that "Customers who volunteer the necessary linkage in the form of their 10 customer id. may be rewarded in some manner. The customer id. may be requested only once and then used for all subsequent sessions in which the customer logs in to the system. Once the linkage is established, the *consumer purchase history data or targeted incentives needed to support this capability of the invention are periodically transferred from the shopper purchase history system to the on-line system of the present invention.*" The examiner ignores that fact that combining data in a data file for data acquired online from the user and another data file obtained from a retail store presents complications and costs computer processing time. One complication is whether there are matching records with the same consumer identification in the database file generated online by the interaction with the user and the and the purchase history data file received from a particular retailer. How will the system handle combining that data into a single file when for example there are records that do not have a common user identification? Moreover, during the presumably long processing time to combine two data files into a single file including the time to determine and associate records which have a common user identification and store records that do not have a common user identification, how will still perform its other functions, of running the interactive Web site and delivering incentives. Memory limitations are also relevant. When combining data into a single file memory size limitations are generally a constraint. Combining data files is impacted by the

physical memory size (number of bits of storage) and logical size constraints (number of bits referencable in an operating system) and hierarchical limitations (number of data objects at any level that may be efficiently referenced, such as the number of files in a folder). These details are often non obvious but real and substantive constraints, particularly in large databases. The undersigned discussed this issue with Steve Greenfield of Catalina on 9-25-2008, via telephone, and again on 9-26-2008, via telephone. Mr. Greenfield is a person knowledgeable on software and database structure issues, and very familiar with Catalina's systems relying there upon. Mr. Greenfield confirmed to the undersigned on 9-25-2008 that there were significant differences between use of one or two database files of the type disclosed in the specification and that the issues raised in this paragraph are real. Mr. Greenfield indicates that those concerns were very important in the 1996 time frame due to the much more limited data processing and data storage technology at that time, but are still issues today. A copy of the email from Rick Neifeld (the undersigned) to Steve Greenfield 9-26-2008 (redacted), showing what Mr. Greenfield reviewed and found accurate is included herewith as Evidence Appendix Attachment 4. The examiner has not considered, and this is probative that one of ordinary skill in the art, would not have considered in view of the teachings in Barnett and Shane, these issues. Therefore, it appears that (1) there are reasons why "integrated database file 42 of fig. 6 or into two separate database files... does ... impact the functionality or utility of the method or system." Moreover, the examiner's statements on the record are probative that such reasons would not have been recognized by one skilled in the art, which indicates that the claim including the claimed database structure, expressly claiming two databases, would not have been obvious.

6. "means for delivering purchasing incentives to consumers by e-mail."

At page 6, the examiner expressly admits that Barnett does not disclose claim 32's "means for delivering purchasing incentives to consumers by e-mail." The examiner states that "Barnett does not ... mention e-mailing coupon data or purchase incentives to the user for subsequent printing." In response, the applicant agrees.

From the end of page 6 to the top of page 8, the examiner discusses Shane. However, the applicant cannot discern the relevance of the examiner's comments.

Shane discloses a "System and method providing an interactive response to direct mail by

creating personalized web page based on URL provided on mail piece". Title. Shane discloses:

A system for providing an interactive response to direct mail programs comprises a recipient database, a mail generator, and a web server computer operationally connected through the Internet to remote computers accessible by direct mail recipients. The recipient database stores data records containing addressing information such as the name, mail, fax or e-mail address, and a unique personal identification code for each direct mail recipient. The mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient. A responding recipient accesses the web server computer by entering the uniform resource locator displayed on the direct mail piece into a web browser on a remote computer. The web server computer retrieves recipient data from the recipient database correlated to the personal identification code contained in the uniform resource locator and uses this recipient data to create a unique interactive web page. [Abstract.]

Respecting email, Shane contains two relevant teachings.

First, Shane contains in the background section the following caution teaching away from using emails for marketing:

Electronic mail ("e-mail") is one possible solution for advertisers. Despite its allure, however, promotional e-mail is still frowned upon, and at present its content is generally limited to unformatted text without graphics. The sender is not even able to determine the font of the e-mail message. Additionally, targeted e-mail lists are not yet available for advertisers. [Column 1 lines 31-37.]

Second, Shane discloses the following alternative implementation at the end of its disclosure, which relies upon email to the user's email address:

While one aspect of the subject invention has been illustrated and described as involving direct mail pieces comprising printed materials assigned postal addresses and sent through standard postal delivery systems (such as through the post office or by courier), it should be understood that with simple and obvious modifications, any form of targeted one-to-one communication may be used in the system or method of the claimed invention. Accordingly, the direct mail pieces may comprise electronic data files provided with e-mail addresses and sent by e-mail. Alternatively, the direct mail pieces may comprise faxes sent by facsimile transmission to specified phone numbers. [Column 8 lines 10-21.]

Thus, Shane does disclose direct one to one communication via email, but also generally teaches away from using email for marketing.

7. Rationale for Modifying Barnett is Unclear

From the bottom of page 8 to the end of page 9, the examiner asserts that Shane suggests modifying Barnett:

to record the user's demographic information including the user's identifying data, e.g. unique code, e-mail address and so on, in a database file 42 of fig. 6 and the user's buying history (online/offline shopping activity) in another and separate database or database file and to enable two different and independent operators or authorized employees, with appropriate rights, to access the respective databases or database files to separately maintain and analyze the data contained therein in order to generate individual user's profile information, based on the collected demographic data and buying history respectively, which is used to produce a merged or combined user's profile useful in crafting targeted coupon data or purchase incentives that are sent to the specific user via e-mail, wherein the content of the e-mail is subsequently printed at the user's computer 6 of fig. 1 using a printing device coupled thereto, thereby ensuring that the user's (combined) profile, generated from data contained in the database files (consumer

database and consumer purchase history database respectively) and used by the issuers or sources to prepare customized coupon packages or purchase incentives e-mailed to the specific user, is accurate and independently produced by two different and independent operators or authorized employees before the result of the independent analyses is merged or combined to form the user's profile, while pro-actively targeting the user by e-mailing customized coupon data packages to the user, based on the combined profile, without the user's intervention or without the user visiting the online service provider 2 web site to view or request the coupon data packages therefrom.

The applicant cannot discern the meaning of the foregoing statement, other than that the examiner asserts that the applied prior art in combination suggests claim 32. For example, the foregoing statement does not follow the rules of English grammar, and it does not specify particular motivation for particular modifications of Barnett's teachings.

In response, for the reasons presented above in connection with the invention defined by claim 32, the examiner errs in concluding that "another and separate database or database file" would have been obvious. Therefore, claim 32's recitation of "A system for delivering incentives over the Internet comprising: ... *a consumer purchase history database* based on consumer online shopping activity [and] *a consumer database which stores e-mail addresses of consumers* " patentably distinguish over the applied prior art.

Similar analysis applies to the obviousness rejections of independent claims 32, 38, 44, 50, 54, 57, and 58, and the rejections of these claims are improper for similar reasons.

F. **Conclusion**

For all of the reasons presented above, the obviousness rejections of independent claims 32, 38, 44, 50, 54, 57, and 58, and the claims that depend therefrom are improper and should be reversed.

VII. 37 CFR 41.37(C)(1)(VIII) CLAIM APPENDIX

Appendix I is attached which contains a copy of the claims involved in the appeal.

VIII. 37 CFR 41.37 (C)(1)(IX) EVIDENCE APPENDIX

Appendix II contains evidence attachments 1-4, which were submitted September 29, 2008 in response to the non-final office action mailed September 17, 2008. This evidence was entered as a matter of right by its filing as part of a response to the non final office action dated September 17, 2008 and it appears in the IFW for the application associated with the date September 29, 2008.

There is no requirement for the examiner to expressly enter evidence in the record of a patent application, and therefore the rule in 37 CFR 41.37 (c)(1)(ix) requiring a statement setting forth where in the record that evidence was entered in the record by the examiner is improper and should be ignored, and should be removed as confusing and inconsistent with the lack of a requirement for the examiner to expressly enter evidence during prosecution.

Attachment 1A is a dictionary definition of "internet address" previously made of record. Attachment 1A was entered in the record as attachment 1 to the appeal brief filed 8/4/2004. The brief filed 8/4/2004 was in response to an office action mailed 5/4/2004 which was in response to the appeal brief filed 3/15/2004. The 3/15/2004 office action mailed 5/4/2004 should have been non final since it was reopening prosecution in response to an appeal brief. The office action mailed 5/4/2004 was improperly made final. The applicant had petitioned for withdrawal of that final status in a petition filed 7/15/2004.

The applicant refiled the dictionary definition of "internet address" with the supplemental appeal brief filed 8/4/2004 as attachment 1 thereto.

The USPTO granted the petition thereby removing the final status in a decision mailed 8/27/2004, thereby effecting entry of attachment 1 filed with the brief on 8/4/2004. In addition, the examiner issued a non final office action reopening prosecution on 10/29/2004 which also would have effected entry of attachment 1A.

The applicant refiled the dictionary definition of "internet address" with the supplemental appeal brief filed 1/28/2005 as attachment 1 thereto. Since this brief was filed in response to a non final office action, it also would have effected entry of attachment 1A

On 4/18/2005, the USPTO issued another non final office action.

On 6/24/2006, the applicant responded by filing another supplemental appeal brief, which the applicant refers to as the third supplemental appeal brief, an attachment 1. Since this brief was filed in response to a non final office action, it too, should have effected entry of attachment 1A.

Evidence attachments 1-4 and attachment 1A are relied upon by the appellant.

IX. 37 CFR 41.37 (C)(1)(X) RELATED PROCEEDINGS APPENDIX

Appendix III contains a summarized listing and copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

X. 37 CFR 47.37 (c)(2)

This brief includes claims amended by the amendment filed September 29, 2008, which was a timely amendment in response to the non-final office action dated September 17, 2008. Applicant's understanding is that such an amendment is entered as a matter of right, that section 37 CFR 47.37 (c)(2) refers to amendments and evidence not admitted of right. Thus, this brief does not include any new or non-admitted amendment or evidence.

XI. 37 CFR 41.37 (d)

This brief complies with the requirements of paragraph (c) of this section.

XII. 37 CFR 41.37 (e)

This notice of appeal and appeal brief are filed timely. Accordingly, no extensions of time are necessary.

10-21-2008

Date

Respectfully Submitted,

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Attorney of Record

BTM/ran

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APPENDIX I - CLAIMS APPENDIX

Claims 1-31. (Canceled).

32. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity,
wherein said consumer purchase history database stores in association with an identification of a consumer identification of all items selected and purchased during a transaction by said consumer;

a consumer database which stores e-mail addresses of consumers, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering purchasing incentives to consumers by e-mail.

33. The system of claim 32 wherein said means for delivering purchase incentives delivers purchasing incentives based on consumer profile.

34. The system of claim 32 wherein the consumer purchase history database and said consumer database are integrated.

35. The system of claim 32 wherein said Web site is an independently administered Web site.

36. The system of claim 32 wherein said Web site is a cooperative site.

37. The system of claim 32 wherein said consumer purchase history database includes data based on past purchasing activity.

38. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity,
wherein said consumer purchase history database stores in association with an identification of a consumer identification of all items selected and purchased during a transaction by said consumer;

a consumer database which stores e-mail addresses of consumers, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
a means for delivering by e-mail notices which remind consumers to visit said Web site.

39. The system of claim 38 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

40. The system of claim 38 wherein the consumer purchase history database and said consumer database are integrated.

41. The system of claim 38 wherein said Web site is an independently administered Web site.

42. The system of claim 38 wherein said Web site is a cooperative Web site.

43. The system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity.

44. A system for delivering incentives over the Internet comprising:
a Web site for providing purchasing incentives from multiple sources;
a consumer purchase history database based on consumer online shopping activity,
wherein said consumer purchase history database stores in association with an identification of a consumer identification of all items selected and purchased during a transaction by said consumer;

a consumer database which stores e-mail addresses of consumers, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and
means for delivering by e-mail notices to purchase a specific manufacturer's product.

45. The system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

46. The system of claim 44 wherein the consumer purchase history database and the consumer database are integrated.

47. The system of claim 44 wherein said Web site is and independently administered Web site.

48. The system of claim 44 wherein said Web site is a cooperative Web site.

49. The system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity.

50. A method for delivering purchasing incentives over the Internet comprising the steps of:

providing a Web site which offers shopping incentives from multiple sources;

maintaining a consumer purchase history database based on consumer online shopping activity, wherein said consumer purchase history database stores in association with an identification of a consumer identification of all items selected and purchased during a transaction by said consumer;

receiving a consumer's e-mail address from a consumer's computer;

maintaining a consumer email database which stores e-mail addresses of consumers; and

transmitting purchase incentives via an e-mail post office.

51. The method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile.

52. The method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator.

53. The method of claim 50 wherein the step of providing a Web site is achieved cooperatively.

54. A method for delivering incentives over the Internet comprising the steps of:
providing a Web site which offers purchasing incentives from multiple sources;
maintaining a consumer purchase history database based on consumer online shopping activity, further comprising storing in association with an identification of a consumer identification provided during a transaction identification of all items selected and purchased during said transaction by said consumer;

receiving a consumer's e-mail address from a consumer's computer;

maintaining a consumer database which stores e-mail addresses of consumers; and

transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

55. The method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator.

56. The method of claim 54 wherein the step of providing a Web site is achieved cooperatively.

57. A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:

a personal database;

a purchase history database wherein the data on the consumer purchases are based on online shopping activity, wherein said purchase history database stores in association with a consumer identification, identification of all items selected and purchased during a transaction associated with said consumer identification;

means for generating a web page with a consumer-specific display;

means for updating said web page; and

means for informing the consumer by e-mail of new incentives.

58. A method for delivery of incentives by e-mail, comprising the steps of:
maintaining a consumer database which stores e-mail addresses of consumers;
receiving during a transaction a consumer identification and identification of all items selected and purchased during said transaction;
storing in a consumer purchase history database, in association with said consumer identification, identification of all items selected and purchased during said transaction;
generating targeted purchase incentives from said consumer purchase history database;
formatting an e-mail message to a consumer having said consumer identification by electronic mail for subsequent printing of a coupon; and
delivering the email message to an email address stored in said consumer database for said consumer.

59. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises shopping list selections data.

60. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises rebate offers data.

61. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data.

62. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data.

63. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons

for subsequent printing by a consumer.

64. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites.

65. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product.

66. The system of claim 32 wherein said consumer purchase history database stores data from any online shopping activity.

67. The system of claim 32 wherein said consumer purchase history database stores an administrator of said system's web site data.

68. The system of claim 32 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands data.

69. The system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address.

70. The system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

71. The system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

72. The system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers.

73. The system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer.

74. The system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale.

75. The system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives.

76. The method of claim 50 wherein said online shopping activity data stored in said

consumer purchase history database comprises shopping list selections associated with a particular consumer.

77. The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer.

78. The method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer.

79. The method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity.

80. The method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer.

81. The method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer.

82. The method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product.

83. The method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site.

84. The method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands.

85. The method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address.

86. The method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

87. The method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

88. The method of claim 50 wherein said purchase incentives include untargted incentives from at least one of manufacturers and retailers.

89. The method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer.

90. The method of claim 50 further comprising printing purchase incentives at point of sale.

91. The method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives.

92. The system of claim 32 wherein at least one of said items was not the subject of a redeemed purchase incentive.

93. The system of claim 38 wherein at least one of said items was not the subject of a redeemed purchase incentive.

94. The system of claim 44 wherein at least one of said items was not the subject of a redeemed purchase incentive.

95. The system of claim 50 wherein at least one of said items was not the subject of a redeemed purchase incentive.

96. The system of claim 54 wherein at least one of said items was not the subject of a redeemed purchase incentive.

97. The system of claim 58 wherein at least one of said items was not the subject of a redeemed purchase incentive.

APPENDIX II - EVIDENCE APPENDIX

Evidence Appendix Attachment 1 - "Web site" definition from "One Look" at

<http://www.onelook.com/?w=Web+site&ls=a>

Evidence Appendix Attachment 2 - "Web Site" definition from Netlingo at:

<http://www.netlingo.com/lookup.cfm?term=Web%20site>

Evidence Appendix Attachment 3 - Ex parte Franks, Appeal No. 2005-0847 (BPAI 9/26/2005)

Evidence Appendix Attachment 4 - Email from Rick Neifeld to Steve Greenfield (9/26/2008)
(redacted)

Evidence Appendix Attachment 1A - Dictionary definition of "internet address",

"Dictionary.com, <http://dictionary.reference.com/search?q=internet%20address>".

APPENDIX III - RELATED PROCEEDINGS

Related Proceedings 1: a copy of the decision on appeal for Appeal No. 2004-1420, Application 09/567,274, mailed August 18, 2004.

Related Proceedings 2: a copy of the decision on appeal for Appeal No. 2004-0989, application 09/401,939, mailed November 22, 2004.

Related Proceedings 3: a copy of the decision on appeal for Appeal No. 2004-0738, application 09/401,198, mailed November 30, 2004.

Related Proceedings 4: a copy of the decision on request for rehearing for Appeal 2004-1420, application 09/567,274, mailed January 31, 2005.

Related Proceedings 5: a copy of the decision on request for rehearing for Appeal No. 2004-0989, application 09/401,939, mailed March 14, 2005.

Related Proceedings 6: a copy of the decision on request for rehearing for Appeal No.2004-0738, application 09/401,198, mailed February 10, 2005.

Related Proceedings 7: a LEXIS copy of the United States Court of Appeals for the Federal Circuit February 10, 2006 decision 05-1353, which affirmed the Board, 164 Fed. Appx. 999; 2006 U.S. App. LEXIS 4064, application 09/567,274.

Related Proceedings 8: a copy of the United States Court of Appeals for the Federal Circuit March 13, 2006 decision 05-1370, which reversed the Board's decision with respect to claims 41-49 and affirmed the Board's decision with respect to claims 50-67, application 09/401,198.

Related Proceedings 9: a copy of the Board's July 27, 2006 order dismissing the appeal and remanding the reexamination proceeding to the examiner, Appeal No. 2006-1585, reexamination

90/005,888.

Related Proceedings 10: a copy of the decision on petitions for Appeal No. 2008-4478, Application 09/401,939, decided July 18, 2008.

Related Proceedings 11: a copy United States Court of Appeal for the Federal Circuit order 2008-1491, reexamination 90/005,888, dated July 29, 2008.

Printed: October 23, 2008 (10:29am)

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10. Web site : Hutchinson Dictionaries [home, info]
11. web site : LookWAYup Translating Dictionary/Thesaurus [home, info]
12. web site : Dictionary/thesaurus [home, info]

➤ Art (1 matching dictionary)

13. Web site : ODLIS: Online Dictionary of Library and Information Science [home, info]

➤ Business (1 matching dictionary)

14. web site : Travel Industry Dictionary [home, info]

➤ Computing (9 matching dictionaries)

15. Web site : Netlingo [home, info]
16. Web site : Hutchinson Dictionary of Computers, Multimedia, and the Internet [home, info]
17. Web site : CCI Computer [home, info]
18. web site : Glossary of Internet Terms [home, info]

Quick definitions (*web site*)

noun: a computer connected to the internet that maintains a series of web pages on the World Wide Web ("The Israeli web site was damaged by hostile hackers")

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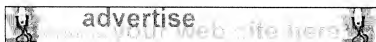
24. [Web site](#) : Prostate Cancer Interactive Glossary [home, info]

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a b c d e f g h i j k l m n o p q r s t u v w :
z

www.netlingo.com

Web site

also seen as website

A place on the World Wide Web that's comprised of files organized into a hierarchy. Each file or document contains text or graphics that appear as digital information on a computer screen. A site can contain a combination of graphics, text, audio, video, and other dynamic or static materials. As a form of media, Web sites are similar to motion pictures, television, or print magazines, which also create and manipulate digital pictures and text. But a Web site is also a communications medium.

The main difference between a Web site and traditional media is that a Web site is on a computer network (the Internet) and is coded in such a way that allows users to interact with it. Once you're on a site, you can make purchases, do searches, send messages, and other interactive activities.

As is the case with many Net terms, "Web site" is often used interchangeably with other words, such as homepage and Web page. For example, you may hear someone refer to their "homepage" when in fact they are talking about an entire Web site. (A homepage is usually a vanity page.) Like homepage, "Web site" is often spelled as one word and not capitalized, as in, "website."

It is important for Web developers to establish a style guide for consistency, which among other things should state whether the preferred usage is the single-word or two-word form. We feel that the two-word form is more grammatically correct; the single-word form is rarely used outside of marketing campaigns. At its bare minimum, a Web site is simply any computer hooked up to the Internet and available via a host name, domain name, or URL.

see also: e-commerce

NetLingo Classification: Net Technology

links

- Time Magazine's 50 Favorite Web Sites of 2006



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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

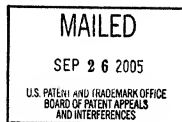
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FELIX FRANKS and ROSS H. M. HATLEY

Appeal No. 2005-0847
Application No. 09/939,689

ON BRIEF



Before WILLIAM F. SMITH, ADAMS, and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 26, 28, 29, 32-34, 38, 39, 41, 43, 46, 47, 52, and 54-68, which are all the claims pending in the application.

Claims 26, 38, 39, 52, 55, 56, 59, 60, 64 and 67 are illustrative of the subject matter on appeal and are reproduced below:

26. A glassy state composition which is storage-stable at 20° C, comprising:
- (1) a carrier substance which is water-soluble or water-swellaible and
 - (2) at least one material to be stored which is dissolved in said amorphous⁽¹⁾ carrier substance;

¹ In the event of further prosecution, we encourage the examiner and appellants to work together to determine whether there is antecedent basis for the term "amorphous" as it appears in claim 26.

DecAppeal_INHA00121CO-US_050927

wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;

wherein said purified biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto;

wherein said composition has the properties that it is storage stable and exists in a glassy state when at 20° C;

wherein a weight ratio of said purified biologically active material to said carrier substance is between about 2:1 and about 1:1; and

wherein said biologically active material is not an enzyme.

38. A method of forming a composition which is storage-stable at 20° C, said composition comprising:

(1) dissolving to form an aqueous solution

(a) a carrier substance which is water-soluble or water-swallowable and

(b) at least one material to be stored;

(2) forming said solution containing said carrier substance with said at least one material dissolved therein into a glassy state by evaporation of liquid water to produce said composition;

wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;

wherein said purified biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto; and

wherein said composition contains no more than 4 percent by weight of water; and

wherein said composition has the properties that it is storage stable and exists in a glassy state when at 20° C; and

wherein said step of dissolving comprises dissolving in an aqueous solution having a pH of about 7;

with proviso that when said at least one material comprises an enzyme, said enzyme comprises an enzyme selected from dehydrogenase enzymes, restriction enzymes, oxidase enzymes and reductase enzymes.

39. A composition which is storage-stable at 20° C, comprising:

(1) a carrier substance which is water-soluble or water-swallowable and is in a glassy state;

(2) at least one material to be stored which is dissolved in said carrier substance;

- wherein said composition exists in a glassy state at 20° C;
 - wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;
 - wherein said purified biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto;
 - wherein said composition contains no more than 4 percent by weight of water; and
 - wherein said biologically active material is not rennin.
52. A composition which is storage-stable at 20° C, comprising:
- (1) a carrier substance which is water-soluble or water-swellaable and
 - (2) at least one material to be stored which is dissolved in said carrier substance;
- wherein said composition has the property that it exists in a glassy state when at 20° C;
- wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution at 20° C;
 - wherein said biologically active material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto; and
 - wherein said biologically active material is not freeze stable; and
- with proviso that when said at least one material comprises an enzyme, said enzyme comprises an enzyme selected from dehydrogenase enzymes, restriction enzymes, oxidase enzymes, and reductase enzymes.
55. A method of rendering a purified biologically active material storage-stable at 20° C and pharmacologically using said material, which material is unstable in aqueous solution at 20° C, comprising the steps of:
- (1) dissolving to form an aqueous solution of
 - (a) a purified biologically active material (i) which is unstable in aqueous solution at 20° C and which is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto and (ii) which is not an enzyme and

- (b) a carrier substance that is water-soluble or water-swellaible;
 - (2) forming said solution into a glassy state composition by evaporating liquid water, wherein said glassy state composition exists when at 20° C; and
 - (3) administering said purified biologically active material stored in said glassy state composition.
- 56. The method of claim 55 wherein said purified biologically active material is selected from the group consisting of immunoglobulin, an enzyme cofactor, a nucleoside, a nucleotide, a dinucleotide, a dimer of a nucleoside, a dimer of a nucleotide, an oligomer of a nucleoside, and an oligomer of a nucleotide.
- 59. The method of claim 55 wherein said purified biologically active material is an immunoglobulin.
- 60. The method of claim 55 wherein said purified biologically active material is a blood clotting factor.
- 64. A method of rendering a purified biologically active material storage-stable at 20° C, which material is unstable in aqueous solution at 20° C. comprising the steps of:
 - (1) dissolving to form an aqueous solution of
 - (a) a purified biologically active material, which is unstable in aqueous solution at 20° C and which is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto and
 - (b) a carrier substance that is water-soluble or water-swellaible;
 - (2) evaporating liquid water from said solution, thereby converting said solution to a glassy state composition, wherein said glassy state composition exists when at 20° C;
wherein said evaporating is done without heating; and
wherein said purified biologically active material is selected from the group consisting of immunoglobulin, an enzyme cofactor, a nucleoside, a nucleotide, a dinucleotide, a dimer of a nucleoside, a dimer of a nucleotide, an oligomer of a nucleoside, and an oligomer of a nucleotide.

67. A glassy state composition which is storage-stable at 20° C, comprising:
- (1) a carrier substance which is water-soluble or water-swellable;
 - (2) at least one material to be stored which is dissolved in said carrier substance;
- wherein said glassy state composition including said carrier substance has the property of being in a glassy state and being storage stable when at 20° C;
- wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution when at 20° C and is selected from the group consisting of immunoglobulin, an enzyme cofactor, a nucleoside, a nucleotide, a dinucleotide, a dimer of a nucleoside, a dimer of a nucleotide, an oligomer of a nucleoside, and an oligomer of a nucleotide.

The reference relied upon by the examiner is:

Koyama et al. (Koyama)

4,824,938

Apr. 25, 1989

GROUND OF REJECTION

Claims 38, 39, 41 and 54 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification that fails to adequately describe the claimed invention.

Claims 38, 39, 41, and 54 stand rejected under 35 U.S.C. § 251 as based upon the introduction of new matter into the application for reissue.

Claims 26, 28, 29, 43, 46 and 52 stand rejected under 35 U.S.C. § 102(e) as anticipated by Koyama.

Claims 32-34, 47 and 55-68 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art.

We affirm the rejection of claims 38 and 54 under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251. We affirm the rejection of claims 26, 28, 29, 43 and 46 under 35 U.S.C. § 102(e). We affirm the rejection of claims 32-34, 47

and 55-68 under 35 U.S.C. § 103. We reverse the rejection of claim 52 under 35 U.S.C. § 102(e); and the rejection of claims 39 and 41 under 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 251.

PROCEDURAL BACKGROUND

The instant application is a reissue application of United States Patent No. 5,098,893². According to appellants (page 2, Paper Received February 15, 2002), "[m]ore than one reissue application has been filed for the reissue of patent number 5,098,893. The reissue applications are application serial numbers 09/270,791, and application serial numbers 09/939,688^[a] and 09/939,689 [the instant application], which are continuation reissue applications of application serial number 09/270,791. Application number 09/270,791 has been allowed^[4]."

² For clarity, we recognize the examiner's finding (page 2, Office Action, mailed December 4, 2002), "[t]he original patent was actually surrendered during the prosecution of the parent reissue application 09/270,791, and therefore the requirement set forth in 37 CFR [§] 1.178(a) has been satisfied." In addition, we note the examiner's finding (id.), "[t]he reissue declaration filed October 3, 2002 is approved." We note, however, the examiner's subsequent caution (bridging paragraph, pages 2-3, Office Action, mailed May 2, 2003), "in view of the subsequent amendments which have been made to this application, [a]pplicants are reminded of the likelihood that a supplemental reissue oath or declaration will have to be filed before this application can be allowed. See MPEP [§] 1444."

³ This application issued as United States Patent No. RE38,385 on January 13, 2004. According to the examiner (Answer, page 2), the obviousness-type double patenting rejection in the instant application based upon Reissue Patent No. 38,385 "has been overcome by the terminal disclaimer filed July 3, 2003...."

⁴ See United States Patent No. RE37,872, issued October 8, 2002. According to the examiner (page 8, Office Action, mailed May 2, 2003), "[t]he obviousness-type double patenting rejection [in the instant application] based upon Reissue Patent No. 37,872 ... is overcome by the terminal disclaimer filed April 3, 2003, which has been approved."

Appellants make the following statement (paragraph 14, Reissue Declaration, filed October 3, 2002), regarding the errors relied upon as the basis for reissue:

I rely upon the statement of the error in the originally filed parent reissue application No. 09/270,791 which is:

In original claim 12, a method claim, with a phrase "and forming the resulting mixture into a glassy amorphous state" arguably encompasses removing water from the mixture by sublimation, also known as freeze drying.

and the statement which is:

The applicants failed to claim a process "of forming a composition which is storage-stable at 20° C, said composition comprising the steps of:

- (1) dissolving to form an aqueous solution
 - (a) a carrier substance which is water-soluble or water-swellaable and
 - (b) at least one material to be stored;
- (2) evaporating liquid water from said solution to convert said solution into a composition in a glassy state;

wherein said composition has the properties that it is storage-stable and exists in said glassy state when at 20° C;

wherein said composition contains no more than 4 percent by weight of water;

wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution when at 20° C;

wherein said at least one material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto; and

wherein said step of evaporating comprises heating the combined carrier substance and purified biologically active material to a temperature not exceeding 80° C"

TECHNICAL BACKGROUND

According to appellants' specification (column 1, lines 4-7⁵), "[t]his invention relates to the stabilization and storage of materials." Specifically, the claims before us on appeal are drawn to compositions, and methods of preparing compositions, comprising a biologically active material that is storage stable and exists in a "glassy state". Beginning at line 51 of column 3, appellants describe "THE GLASS-FORMING SUBSTANCE". According to appellants (specification, column 3, lines 52-60),

A glass is defined as an undercooled liquid with a very high viscosity....

Normally a glass presents the appearance of a homogeneous, transparent, brittle solid which can be ground or milled to a powder. In a glass, diffusive processes take place at extremely low rates, such as microns per year. Chemical or biochemical changes including more than one reacting moiety are practically inhibited.

According to appellants (specification, column 4, lines 57-60), "[c]arbohydrates are an important group of glass forming substances: thus candy is a glassy form of sugar.... The T_g for ... maltotriose ... [is] 76° C...." According to appellants (specification, column 4, lines 12-15), "[f]or this invention it will generally be necessary that the glass forming substance, when anhydrous or nearly so, displays a glass transition temperature T_g in a range from 20 to 150° C" Once stored in a glassy state, the biologically active material may be recovered by "adding water or aqueous solution to a quantity of the glass with the active material therein." Specification, column 6, lines 61-63.

⁵ Since the instant application is a reissue application of United States Patent No. 5,098,893 ('893), all references to appellants' specification will be to the specification of the '893 patent.

DISCUSSION

Written Description:

Claims 38, 39, 41 and 54 stand rejected under 35 U.S.C. § 112, first paragraph, on the basis that the specification fails to adequately describe the claimed invention.

Claims 38 and 54

According to appellants (Brief, page 10), claims 38 and 54 stand or fall together. Accordingly, we limit our discussion to representative independent claims 38. Claim 54 will stand or fall together with claim 38. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). The examiner finds (Answer, page 4), claim 38 recites "dissolution in an aqueous solution having a pH of about 7, which embraces dissolution at slightly acidic pHs." According to the examiner (id.), "there is no original disclosure in the specification of dissolution at slightly acidic pHs, the only pHs recited in the sections of the specification cited by [a]pplicants [is a pH] ranging from 7.0 to 7.6." Accordingly, the examiner finds (id.), "the pH range recited in ... [claim 38] is not supported by the original disclosure of the invention."

In response, appellants assert (Brief, page 12),

[w]hile the phrase "about 7" is not verbatim disclosed in the original specification, the claimed invention does not have to be described literally in the specification to satisfy the description requirement. The claim language "about 7" is a mere rephrasing of what the specification would have conveyed to one of ordinary skill in the art in view of the pH's of the solutions actually disclosed. Therefore, the claimed phrase "pH of about 7" does not constitute new matter.

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention as defined by the claims. As the examiner explains (Answer, page 4), the phrase "having a pH of about 7" reads on a pH outside those pHs recited in appellants' specification. Accordingly, it is our opinion that the examiner met his burden. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). Therefore, appellants have the burden of demonstrating that the specification's disclosure of pH 7.0, 7.5 and 7.6 provides written descriptive support for "a pH of about 7" as set for in appellants' claim 38. While appellants assert, "a pH of about pH 7 is simply a rephrasing of what their specification would have conveyed to one of ordinary skill in the art," they provide no evidence to support this assertion. It is not clear on this record, how a description of three specific pHs, pH 7.0, pH 7.5 and pH 7.6, describes about pH 7.0. See e.g., Answer, bridging paragraph, pages 7-8, "three specific pHs of 7.0, 7.5, and 7.6 do not convey that [a]ppellants contemplated the acidic pHs embraced by the claim language."

For the foregoing reasons, we affirm the rejection of claim 38 under the written description provision of 35 U.S.C. § 112, first paragraph. As set forth above, claim 54 falls together with claim 38.

Claims 39 and 41

In the first action on the merits of the instant application, the examiner rejected then pending claims 17⁶, 19, 25, 40 and 42-44 under 35 U.S.C. § 102(b) as being anticipated by the Shah dissertation.⁷ In addition, the examiner rejected claims 26-29, 32-35 and 38 under 35 U.S.C. § 103 as being obvious over the Shah dissertation. See pages 11-13, Office Action, mailed June 3, 2002. According to the examiner (id. at page 11), "[t]he Shah dissertation teaches[, inter alia,] combining rennin, an enzyme, with preservatives such as gelatin (a synthetic polymer as well as a water soluble and a water-swellaable synthetic polymer), dextrin, hydroxyethyl starch, and sucrose (a disaccharide) in an aqueous solution and spray-drying the aqueous solution." In the same Office Action, the examiner rejected claims 21, 31, 37-39 and 41 under 35

⁶ For clarity, then pending claim 17 is reproduced below:

17. A process of forming a composition which is storage stable at 20° C, said composition comprising the steps of:

- (1) dissolving to form an aqueous solution
 - (a) a carrier substance which is water-soluble or water-swellaable and
 - (b) at least one material to be stored;
- (2) evaporating liquid water from said solution to convert said solution into a composition in a glassy state;
 - wherein said composition has the properties that it is storage-stable and exists in said glassy state when at 20° C;
 - wherein said composition contains no more than 4 percent by weight of water;
 - wherein said at least one material comprises a purified biologically active material that is unstable in aqueous solution when at 20° C;
 - wherein said at least one material is selected from the group consisting of peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes, enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto; and
 - wherein said step of forming comprises heating the combined carrier substance and purified biologically active material to a temperature not exceeding 80° C.

⁷ We note that an additional rejection of claims 17, 19, 25, 40 and 42-44 was made under 35 U.S.C. § 102(b) as being anticipated by the Shah dissertation further in view of Forshoff and appellants' admitted prior art at column 4, line 66 and column 5, lines 3-8. See page 12, Office Action, mailed June 3, 2002.

U.S.C. § 251, and 35 U.S.C. § 112, first paragraph, asserting "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 21, 31, 37, 39, and 41." See id., at pages 3-4.

According to the examiner (Answer, page 4), "[r]ennin is not mentioned in the disclosure, and silence in the specification is not support for a negative claim limitation." Accordingly, the examiner finds (Answer, page 4), "[t]here is no original disclosure supporting the exclusion of rennin as is recited in instant claims 39 and 41." In support of this rejection, the examiner relies on Ex parte Grasselli, 231 USPQ 339, aff'd on reh'g, 231 USPQ 395 (Bd. Pat. App. & Int. 1983).

In response, appellants admit (Brief, page 11), "the specification of this application does not mention rennin." According to appellants (id.), the claims "specifically exclude[] rennin only because of the reference to rennin in the Shah reference." Appellants assert, however, "that [this] does not mean that the applicant's [sic] were not in possession of the genus of the inventions claimed by claims 39 and 41, either including or excluding rennin." According to appellants (Brief, bridging paragraph, pages 11-12),

there is no rational basis for a rule of law precluding negative limitations that exclude a species anticipating a generic claim when the reference does not teach the generic utility of the claimed invention. That is the case here. To the extent case law is inconsistent with this reasoning, it should be overruled....

There can be no doubt that appellants have written descriptive support for a composition which comprises, inter alia, "peptides, proteins, nucleosides, nucleotides, dimers or oligomers of nucleosides or nucleotides, enzymes,

enzyme cofactors and derivatives of any of the foregoing, said derivatives having one or more additional moieties bound thereto..." as set forth in claims 39 and 41. See e.g., specification, column 2, line 63 to column 3, line 49. It is also clear that appellants' specification provides descriptive support for a subgenus within the genus of proteins that includes enzymes, transport proteins, e.g., haemoglobin, immunoglobulins, hormones, and blood clotting factors. See e.g., specification, column 3, lines 3-6. In addition, appellants specifically describe a number of enzymes including for example, the restriction endonuclease Eco RI (specification, Example 3), glutamate dehydrogenase (specification, Example 5), ascorbate oxidase (specification, Example 6), and Cytochrome C reductase (specification, Example 8).

As we understand the examiner's rejection, notwithstanding appellants' disclosure of a subgenus of proteins drawn to enzymes, and their specific disclosure of a number of enzymes within this subgenus, there is inadequate written descriptive support for appellants' claims that exclude the enzyme rennin. Apparently, it is the examiner's opinion that appellants have failed, per se, to provide adequate written descriptive support for claims that exclude the enzyme rennin, because "rennin" is not mentioned in appellants' specification.

We find the facts on this record to be substantially similar to those in In re Johnson, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977). In Johnson, appellants narrowed their claims to avoid having them read on a lost interference count. On this record, appellants narrowed their claims to avoid

having them read on the prior art. As set forth in Johnson, at 1019, 194 USPQ at 196,

The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and use, that genus minus two of those species, and has thus failed to satisfy the requirements of § 112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute.

The examiner failed to explain why after disclosing the genus - proteins, the subgenus – enzymes, and specifically describing several enzymes within the subgenus, that appellants have not described a composition as set forth in claims 39 and 41, wherein the biologically active material is not rennin. In our opinion, having described the whole, appellants have necessarily described the part remaining. Cf. id.

Accordingly, we reverse the rejection of claims 39 and 41 under 35 U.S.C. § 112, first paragraph.

New Matter:

Claims 38, 39, 41, and 54 stand rejected under 35 U.S.C. § 251 as based upon the introduction of new matter into the application for reissue. The rationale relied upon by the examiner to support the rejection of claims 38, 39, 41, and 54 stand rejected under 35 U.S.C. § 251 is exactly the same as rationale the examiner provides for the rejection under 35 U.S.C. § 112, first paragraph. In addition, appellants assert (Brief, page 21), the rejection under 35 U.S.C.

§ 251 "should be reversed for the same reasons stated in response to the rejection of claims under 35 U.S.C. [§] 112[, first paragraph]."

Claims 38 and 54

For the foregoing reasons, we affirm the rejection of claims 38 and 54 under 35 U.S.C. § 251, for the same reasons set forth above with regard to the rejection under 35 U.S.C. § 112, first paragraph.

Claims 39 and 41

For the foregoing reasons, we reverse the rejection of claims 39 and 41 under 35 U.S.C. § 251, for the same reasons set forth above with regard to the rejection under 35 U.S.C. § 112, first paragraph.

Anticipation:

Claims 26, 28, 29, 43, 46 and 52 stand rejected under 35 U.S.C. § 102(e) as anticipated by Koyama. According to appellants (Brief, page 10), claims 26, 28, 29, 43 and 46 stand or fall together. Claim 52 stands or falls alone. Accordingly, we limit our discussion to representative independent claims 26 and 52. Claims 28, 29, 43 and 46 will stand or fall together with claim 26. Young.

Claim 26

According to the examiner (Answer, page 4), Koyama "teach[es] stabilized water-soluble dry solid compositions comprising proteinaceous bioactive

substances, for example hormones. Aqueous solutions of the proteinaceous bioactive substances are combined with aqueous solutions [of] a polysaccharide composed mainly of maltotriose units at a ... weight ratio of the polysaccharide to the substance ... [of] at least 0.5...." The examiner finds (id.), "[t]he combined solutions are then dried, either by conventional procedures at reduced pressure and a temperature below 30°C, or else by freeze-drying." The examiner further finds (id.), "[i]n one series of examples, greater than 90% of activity is retained after storage at 37°C for one month...."

Based on this evidence, the examiner concludes (Answer, bridging paragraph, pages 4-5), "[i]n view of the similarity in the components of the compositions and the retained activity of the compositions, the compositions of Koyama ... are deemed inherently to have the same storage stability ... claimed by [a]pplicants...."

Claim 26 is drawn to a "glassy state composition which is storage-stable at 20° C." Claim 26 is not drawn to a particular method of forming a so-called "glassy state composition," nor is does it include any process limitations relating to the formation of a glassy state composition. Therefore, the claims read on a glassy state composition that is storage-stable at 20° C, produced by any method.

Against this backdrop, we take a closer look at the evidence of record.

First: Koyama teach a composition that comprises a polysaccharide mainly composed of repeating maltotriose units, specifically pullulan and elsinan. See e.g., Koyama, abstract; Accord, Answer, page 4. There is no

dispute on this record that a polysaccharide mainly composed of repeating maltotriose units, e.g., pullulan and elsinan are not water-soluble or water-swellaible. Therefore, as we understand it, Koyama teaches a carrier substance as described in numbered clause (1) of appellants' claim 26.

Second: Koyama teach non-enzyme proteins dissolved in the carrier substance. Koyama, Examples 1 through 7; Accord, Answer, page 4. There is no dispute on this record that the non-enzyme proteins taught by Koyama are not biologically active materials that are unstable in aqueous solution at 20° C. Therefore, as we understand it, Koyama teaches a purified biologically active material as described in the first, second and last wherein clause, as well as, numbered clause (2) of appellants' claim 26.

Third: Koyama teach "[t]he weight ratio of the polysaccharide to the substance is at least 0.5...." Koyama, column 2, lines 44-45; Accord, Answer, page 4. Therefore, as we understand it, Koyama teach a weight ratio of said purified biologically active material to said carrier substance is between about 2:1 and about 1:1, as set forth in the fourth wherein claims of appellants' claim 26.

Fourth: Koyama teach the dry solid obtained by following the teachings of their specification "is readily dissolvable in water, and very stably retains the activity of a proteinaceous bioactive substance." Koyama, column 2, lines 60-62; Accord Answer, page 4. In this regard, we note that Koyama demonstrate that a dry solid composition comprising e.g., pullulan and human IFN retained 100% of its activity after storage at 37° C for two months. Koyama, Experiment

1-B and Table 1, bridging columns 3-4; Accord, Answer, page 4. Therefore, as we understand it, Koyama teach a composition that has the properties that it is storage stable at 20° C, as set forth in the preamble and third wherein clause of appellants' claim 26.

Fifth: Koyama does not use the term "glassy state" to characterize his dry composition. We note, however, that appellants disclose (column 4, lines 12-15) "[f]or this invention it will generally be necessary that the glass forming substance [e.g., a maltotriose-based carrier], when anhydrous or nearly so, displays a glass transition temperature T_g in a range from 20 to 150° C." With reference to L. Slade and H. Levine, Non-equilibrium behavior of small carbohydrate-water systems, Pure Appl. Chem. 60[:]1841 (1988), appellants' disclose (column 4, lines 59-63), "[t]he T_g for ... maltotriose ... [is] 76° C." Thus, the T_g for maltotriose is within the range disclosed by appellants to be generally necessary to form a glass. There is no evidence on this, nor is there any dispute, that the maltotriose-based polysaccharides pullulan and elsinan would not have a T_g in a range from 20 to 150° C.

Based on the foregoing, it is our opinion that since the claimed and prior art products contain the same ingredients and can be produced by identical or substantially identical processes, they would have similar properties, including existing "in a glassy state." Therefore, it is our opinion that the examiner has set forth the evidence necessary to establish a prima facie case of anticipation, and thereby shift the evidentiary burden to appellants under the principles set forth in

In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977),

[w]here, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.... Whether the rejection is based on "inherency" under 35 U.S.C. 102, or "prima facie obviousness" under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products [citations and footnote omitted].

When the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicants have the burden of showing that they are not. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). As set forth in In re Swinehart, 439 F.2d 210, 212-213, 169 USPQ 226, 229 (CCPA 1971)

It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

We now consider appellants' rebuttal evidence.

First: appellants assert that Koyama "does not disclose any freeze drying conditions." Brief, page 13. Apparently, appellants are of the opinion that a person of skill in the art would not understand how to perform a freeze-drying process. However, as appellants recognize (appellants' specification, column 1, lines 29-66), "[t]he commonest method for the stabilization of isolated protein

preparations is freeze-drying." We also note that this section of appellants' specification provides a brief review of the known process known as freeze-drying. Accordingly, we are not persuaded by appellants' intimation that anything more than routine steps, known to those in the art at the time of Koyama's disclosure are required to perform the freeze-drying process according to Koyama's disclosure.

Second: appellants assert (Brief, page 13), Koyama teach that the non-maltotriose based stabilizers⁸, otherwise referred to on this record as ineffective stabilizers⁹, do not provide high stability. From this appellants assert (Brief, page 14), "[i]f Koyama's drying conditions resulted in the glassy state, all of Koyama et al.'s samples would have been stabilized...." In support of this assertion appellants direct our attention to the results obtained for compositions comprising dextran as the carrier substance as taught by appellants and Koyama. According to appellants (id.), Koyama's dextran stabilized compositions "retained only 65.3% ... activity after being stored for two months at 37° C." In contrast, appellants assert that their dextran stabilized compositions "exhibit greater than 91% activity when stored at 25° C for 8 and 10 weeks, respectively." Id.

A closer look at the data is necessary to clarify appellants' assertions. To begin, however, we do not understand Koyama to teach that compositions

⁸ We note that the terms "stabilizer(s)" and "carrier" are used interchangeably on this record.

⁹ See e.g., Answer, page 8, wherein the examiner distinguishes Koyama's "ineffective stabilizers", from Koyama's "inventive polysaccharides," those composed of repeating altotriose units, such as pullulan and elsinan. See e.g., Koyama, Abstract, and column 2, lines 37-41.

comprising non-maltotriose based carriers are not stabilized. Instead, we understand Koyama to teach that non-maltotriose based stabilizers do not stabilize a biologically active material as well as compositions comprising maltotriose based carriers.

In addition, while appellants emphasize the retention of a particular amount of activity, claim 26 simply requires that the composition be "storage stable." There is no requirement in claim 26 that a particular amount of activity be retained during storage. We also find no disclosure in appellants' specification that would define "storage stable" as having a particular amount of retained activity. Stated differently, we find no nexus between "[a] glassy state composition which is storage-stable at 20° C" and the retention of a particular amount of activity.

Nevertheless, we will consider appellants' argument regarding activity. While appellants focus our attention only on the dextran data provided in their specification and in Koyama, we elect to consider both the dextran and the maltotriose data found in both appellants' specification and in Koyama. In this regard, we note that appellants report (appellants' specification, Table at column 13) that for compositions stored at 25° C the retained activity of,

1. maltotriose (114%) was better than dextran (81%) at week 2.
2. maltotriose (91%) was better than dextran (71%) at week 4.
3. maltotriose (96%) was better than dextran (89%) at week 6.
4. maltotriose (101%) was better than dextran (95%) at week 12.
5. maltotriose (94%) was better than dextran (84%) at week 16.

This is completely consistent with the observation in Koyama wherein, for example, the maltotriose-based carriers pullulan and elsinan stabilized human IFN better than dextran when stored at 37° C for two months (retained activity of pullulan 100% and elsinan 99.1% vs. dextran 65.3%). See Koyama, Table I, bridging columns 3 and 4).

There is no doubt that appellants' table reports an inversion in the general trend that maltotriose is a better stabilizer than dextran at weeks 8 and 10. See e.g., id., wherein at week 8 dextran based compositions retain 102% of their activity relative to maltotriose based compositions retaining 68%. Appellants offer no explanation for, nor do they even recognize, this inversion in the general trend reported in their Table. Accordingly, in the absence of evidence to the contrary, we consider the data presented for weeks 8 and 10 to be outliers, which are inconsistent with the general trend reported for the stabilization of compositions with either maltotriose or dextran for weeks 2-6, 12 and 16 as reported in their data. Therefore, we are not persuaded by appellants' assertion that because their data reports a different result for weeks 8 and 10 than is reported by Koyama, the products must be different. In our opinion, the evidence of record does not support this conclusion.

Therefore, we disagree with appellants' assertion (Brief, page 14), "[t]he only reasonable conclusion to draw from these facts is that Koyama's dextran containing samples were not in a glassy state." To the contrary, for the reason set forth above, we find it reasonable to conclude that the data set forth in appellants' table for weeks 8 and 10 is affected with some sort of experimental

error, which caused an inversion over the general trend set forth in the data, and causing dextran based compositions to retain more activity (102%, for week 8), than they originally started with.

For the foregoing reasons, it is our opinion that appellants failed to carry their burden to refute the examiner's prima facie case of anticipation. Accordingly, we affirm the rejection of claims 26 under 35 U.S.C. § 102(e) as anticipated by Koyama. As set forth above, claims 28, 29, 43 and 46 fall together with claim 26.

For his part, the dissent agrees (infra, page 35) that Koyama supports a prima facie case of obviousness (see infra, page 26) with respect to claims 55, 56, 59, 60, 64 and 67, because Koyama suggests stabilizing "proteinaceous bioactive substances...." The dissent disagrees, however, that Koyama anticipates claim 26, because claim 26 "is directed to a 'glassy state composition.'" We respectfully point out that claims 55, 56, 59, 60, 64 and 67 also require a "glassy state" composition. See e.g., claim 55, step (2). Accordingly, as we understand it, the dissent's underlying rationale for distinguishing the claims appears to be flawed.

Nevertheless, we agree with the dissent that appellants' specification describes a process of making a glassy state composition that is an alternative to freeze-drying. See infra, page 39. However, while appellants' specification describes an alternative process to freeze-drying, there is no evidence on this record that the glassy state composition as set forth in claim 26 and described in appellants' specification cannot be prepared by freeze-drying. Appellants

appear to recognize this in their Reissue Declaration (filed October 3, 2002, paragraph 14), with regard to method claim 12 of the originally filed reissue application appellants assert the phrase “‘forming the resulting mixture into a glassy amorphous state’ arguably encompasses removing water from the mixture by sublimation, also known as freeze drying.”

The dissent attempts to distinguish freeze-drying from appellants’ alternative process of producing a “glass state” composition by emphasizing (*infra*, page 38) appellants’ description of their alternative process as, more “cost effective” than freeze-drying (column 2, lines 21-23), more energy efficient than freeze-drying (column 2, lines 60-61), and “more economical than freeze-drying” (column 4, lines 27-29). We fail to see, however, how statements relating to cost, and efficiency demonstrate that freeze-drying, as taught by Koyama and discussed above, does not result in a glassy state composition.

Nevertheless, the dissent directs our attention to example 13 of appellants’ specification in an attempt to support his opinion that freeze-drying will not result in a glassy state composition. At the outset, we note that the biologically active material of appellants’ example 13 is an enzyme – lactate dehydrogenase. Enzymes, however, are specifically excluded from the scope of claim 26. See claim 26, last clause. In addition, while the dissent recognizes (*infra*, page 39) that example 13 discusses “several different carriers” including maltotriose, the dissent limits his focus to “dextran”, and more specifically to the data for week 8, wherein the enzyme stabilized in dextran retained more activity than it originally started with. We find it curious, however, that like appellants

the dissent offers no explanation regarding, for example, the retained activity of the enzyme in dextran at weeks 2 and 4 (81% and 71% respectively), which is significantly less than the enzyme's retained activity at week 8 (102%). Stated differently, the activity of the enzyme appears to decrease when stored in a "glassy state" in dextran, up to week 8 wherein the activity of the enzyme exceeds its original activity.¹⁰ Nevertheless, for the reasons set forth above, we are not persuaded by the dissent's focus on dextran, or the data presented in appellants' example 13 to distinguish the claimed "glassy state" composition, from the composition taught by Koyama.

We recognize the dissent's reference to the definition of a "glass" as it appears in column 3, lines 52-64 of appellants' specification. Infra, page 35. In particular, we note the dissent's reference to the glass transition temperature (T_g). According to appellants' specification (column 4, lines 12-15), "[f]or this invention it will generally be necessary that the glass forming substance, when anhydrous or nearly so, displays a glass transition temperature T_g in a range from 20 to 150° C...." We respectfully point out that maltotriose has a T_g of 76° C, well within the T_g range disclosed by appellants. Accordingly, since the components of the composition are the same and the process for preparing the composition can be the same, there is no evidence on this record that different results will be obtained.

¹⁰ We disagree with the dissent's intimation (infra, page 39) that the only meaningful data presented in appellants' table is the data for week 8, thereby ignoring the evidence of record that provides context for this single data point.

Accordingly, we are not persuaded by the dissents' attempt to distinguish Koyama's composition from the composition set forth in appellants' claim 26.

Claim 52

Claims 52 stands on a different footing. As illustrated above, claim 52 requires that "said biologically active material is not freeze stable." The examiner failed to identify, and we are unable to find, a portion of Koyama that teaches that the proteinaceous biologically active material is not freeze stable. As appellants point out (Answer, page 15), "[t]he examiner does not address this limitation in the rejection of claim 52 as being anticipated by Koyama...." In this regard, we remind the examiner "[u]nder 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). "Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Since the examiner does not address the requirement in claim 53 that the "biologically active material is not freeze stable", and Koyama does not expressly address non-freeze stable biologically active materials, we are compelled to reverse the rejection of claim 52 under 35 U.S.C. § 102(e) as anticipated by Koyama.

Obviousness:

Claims 32-34, 47 and 55-68 stand rejected under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art. According to appellants (Brief, page 10), claims 32-34, 47, 55, 57, 58 and 61-63 stand or fall together; claims 56 and 68 stand or fall together; claims 64-66 stand or fall together; and each of claims 59, 60 and 67 stand or fall alone. Accordingly, we limit our discussion to representative claims 55, 56, 59, 60, 64, and 67. Claims 32-34, 47, 57, 58 and 61-63 will stand or fall together with claim 55; claim 68 will stand or fall together with claim 56; and claims 65 and 66 will stand or fall together with claim 64. Young.

Claim 55

The examiner relies on Koyama as set forth above. Answer, page 5. While the examiner finds (Answer, page 4) that Koyama teach that the aqueous polysaccharide-proteinaceous bioactive substance composition can be dried, "either by conventional procedures at reduced pressure and a temperature below 30°C, or else by freeze-drying¹¹," the examiner finds (Answer, page 5), Koyama does "not teach any examples in which conventional drying procedures at reduced pressure and a temperature below 30°C are used." Nevertheless, the examiner asserts (id.),

it would have been obvious to one of ordinary skill in the art at the time [a]pplicants' invention was made to form the dried compositions of Koyama et al[.] using conventional drying

¹¹ See Koyama, column 2, lines 52-56.

procedures at reduced pressure and at a temperature below 30°C¹² because as admitted by Koyama et al[.], such drying procedures are conventional and are suitable for producing Koyama et al[.]’s desired products, and because as admitted by [a]pplicants at column 1, lines 59-62, of the application, freeze-drying is costly in capital and energy and is irreproducible.

With reference to the Franks Declaration dated October 2, 2000, appellants assert (Brief, page 17), “in 1989¹³, there was no non-freeze drying ‘conventional’ drying procedures carried out at a reduced pressure and temperature below 30°C’ ... used on proteinaceous bioactive compounds.” According to appellants (id.), “[o]ne of ordinary skill in the art in 1989 reading Koyama would have recognized the non-freeze drying language ... as mere surplusage unsupported by any experimental results or process conditions, and therefore would not have been motivated to dry without freeze drying. According to appellants (Brief, page 18),

[e]ven assuming for the sake of argument one of ordinary skill in the art in 1989 was in fact motivated to dry an aqueous unstable material without freeze drying, there was no teaching suggesting using the degree of drying required to obtain a composition that is in a glassy state when existing at 20°C. Because those skilled in the art did not know that the amount of residual water was significant, it is likely that following Koyama’s suggestion to experiment with non-freeze drying would not have resulted in a glassy state material.

In addition, appellants argue (id.),

At best, the passage in Koyama’s reference to a non-freeze drying process ... was a motivation to experiment since (1) it did not identify any process conditions relating to the reduced pressure and temperature (e.g., time of reduced pressure and heat energy

¹² Thereby reaching the requirement of claim 55 wherein a glassy state composition is formed “by evaporating liquid water...”

¹³ Koyama was filed August 31, 1987 and issued April 25, 1989.

to be input to maintain temperature above freezing) that would have resulted in a dry solid containing a proteinaceous bioactive substance ... and (2) it did not relate those process conditions to what was required to achieve the intended stability.

With reference to the Franks Declaration dated October 2, 2000, appellants assert (Brief, bridging sentence, pages 17-18), "one of ordinary skill in the art in 1989 would have believed that drying purified biologically active samples without first freezing them would destroy an unacceptably large fraction of their activity." From this appellants assert (Brief, page 19), "Koyama, provides, at best, a motivation to experiment, not a suggestion to try a specified processing procedure. Moreover, it provides no reasonable expectation of success for a non-freeze dried procedure. For both of these reasons, the obviousness rejections based upon the teachings of Koyama are improper and should be withdrawn."

We agree with appellants, that in order to establish a prima facie case of obviousness, there must be some suggestion or motivation to modify the references or combine reference teachings and a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). We also agree with the examiner (Answer, page 9), "[a]ll the disclosures in a reference must be evaluated ... a reference is not limited to the disclosure of specific working examples." In re Mills, 470 F.2d 649, 651, 176 USPQ 196, 198 (CCPA 1972). In this regard, we note the examiner's argument (Answer, page 10), that Koyama "specifically claim drying the aqueous solution at a temperature below 30°C and reduced pressure (see claim 6), which is further

evidence of the obviousness of such a drying step." Accordingly, we are not persuaded by appellants' assertion that a person of ordinary skill would not have been able to practice Koyama's non-freeze drying process without undue experimentation. In re Michalek, 162 F.2d 229, 231-32, 74 USPQ 107, 109 (CCPA 1947) ("in a patent it is to be presumed that a process, if used by one skilled in the art, will produce the product alleged by the patentee...."). In our opinion, Koyama provides express direction to prepare a dry composition comprising a maltotriose based stabilizer and a biologically active material by evaporating liquid water at a temperature below 30°C and reduced pressure. See e.g., Koyama, claim 6. Therefore, notwithstanding appellants' assertions to the contrary, in our opinion, Koyama provides both the suggestion and a reasonable expectation of success producing a water-soluble dry solid composition by evaporating liquid water at a temperature below 30°C and reduced pressure. Regarding appellants arguments concerning the retention of activity or degree of drying, we agree with the examiner's finding (Answer, page 11), there is no requirement in appellants' claim 55 regarding the retention of a particular amount of activity or that the composition contain a particular amount of water.

For the foregoing reasons we affirm the rejection of claim 55 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art. As set forth above, claims 32-34, 47, 57, 58 and 61-63 fall together with claim 55.

Claim 56

According to appellants (Brief, page 20),

there is no teaching relied upon by the examiner suggesting, in addition to the limitations discussed above including evaporating liquid water, a method wherein the purified biologically active material is selected from immunoglobulin, an enzyme cofactor, a nucleoside, a nucleotide, a dinucleotide, a dimer of a nucleoside, a dimer of a nucleotide, an oligomer of a nucleoside, and an oligomer of a nucleotide

as required by appellants' claim 56.

The examiner recognizes (Answer, page 6), Koyama does "not teach drying proteins such as enzymes, transport proteins, immunoglobulins, and blood clotting factors." Nevertheless, the examiner asserts (id.),

[i]t would have been obvious to one of ordinary skill in the art at the time [a]pplicants' invention was made to dry proteins such as enzymes, transport proteins, immunoglobins, and blood clotting factors in the methods of Koyama et al[.] because these are known proteinaceous substances which it would be desirable to be able to store and because Koyama et al[.]'s method is applicable to all proteinaceous substances which exhibit a bioactivity in vivo.

We agree.¹⁴ As set forth in In re Rosselet, 347 F.2d 847, 851, 146 USPQ 183, 186 (CCPA 1965). "[t]he test for obviousness is not express suggestion of the claimed invention in any or all of the references but rather what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them."

¹⁴ Of interest, we note that appellants' position appears to be in conflict with their position that one of ordinary skill in the art would envision the enzyme "rennin" in their disclosure of a subgenus drawn to "enzymes".

For the foregoing reasons we affirm the rejection of claim 56 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art. As set forth above, claim 68 falls together with claim 56;

Claim 59

According to appellants (Brief, page 20), there is no teaching in Koyama to suggest evaporating liquid water, or to use "an immunoglobulin" as the biologically active material as is required by appellants' claim 59. For the reasons set forth above, we are not persuaded by appellants' arguments concerning evaporating liquid water. As to the use of "an immunoglobulin" the examiner asserts (Answer, page 12), immunoglobulins "are known substances which like all chemical have to be stored and have to be stored in such a manner so as to maintain their activity." According to the examiner (id.), since Koyama "is applicable to all proteinaceous substances which exhibit a bioactivity in vivo, it would have been obvious to use the process of Koyama ... to store these particular proteinaceous substances." We agree. Accordingly, we affirm the rejection of claim 59 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art.

Claim 60

According to appellants (Brief, page 20), there is no teaching in Koyama to suggest evaporating liquid water, or to use "a blood clotting factor" as the biologically active material as is required by appellants' claim 60. For the

reasons set forth above, we are not persuaded by appellants' arguments concerning evaporating liquid water. As to the use of "a blood clotting factor" the examiner asserts (Answer, page 12), blood clotting factors "are known substances which like all chemical have to be stored and have to be stored in such a manner so as to maintain their activity." According to the examiner (id.), since Koyama "is applicable to all proteinaceous substances which exhibit a bioactivity in vivo, it would have been obvious to use the process of Koyama ... to store these particular proteinaceous substances." We agree. Accordingly, we affirm the rejection of claim 60 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art.

Claim 64

According to appellants (Brief, page 20), there is no teaching in Koyama to evaporating liquid water without heating, as required by appellants' claim 64.

In response the examiner asserts (Answer, bridging paragraph, pages 12-13), Koyama "describe conventional drying procedures at reduced pressure and a temperature 'below 30°C.... At such temperatures, there is at best minimal heating involved. Further, the disclosed temperature range renders prima facie obvious the determination of optimum temperatures within the disclosed temperature range, which includes those at which no heating occurs. We agree. Accordingly, we affirm the rejection of claim 64 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art. As set forth above, claims 65 and 66 fall together with claim 64.

Claim 67

According to appellants (Brief, page 20), "[i]ndependent claim 67 defines a composition that exists in a glassy state at 20°C. Koyama does not suggest [or] disclose storage stable compositions that exist in a glassy state when at 20°C." For the foregoing reasons, it is our opinion that the examiner has met his burden of setting forth a plausible prima facie case of obviousness. Best. Accordingly, the burden of going forward with evidence or argument was properly shifted to the appellants. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). However, as the examiner asserts (Answer, page 9), "[a]ppellants have not submitted any probative evidence that Koyama ... do not produce dried compositions in a glassy state, or that Koyama[s] ... compositions are not storage-stable at 20°C." For the foregoing reasons we are not persuaded by appellants' unsupported arguments. Accordingly, we affirm the rejection of claim 67 under 35 U.S.C. § 103 as being unpatentable over Koyama in view of appellants' admitted prior art.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


William F. Smith

Administrative Patent Judge



Donald E. Adams

Administrative Patent Judge

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GRIMES, Administrative Patent Judge, dissenting in part.

I agree with the majority that claim 52 is not anticipated and that claim 39 finds adequate support in the specification while claim 38 does not. I also agree that Koyama supports a prima facie case of obviousness with respect to claims 55, 56, 59, 60, 64, and 67: Koyama suggests stabilizing "proteinaceous bioactive substances" (which reasonably includes immunoglobulins and blood clotting factors) by mixing them with a maltotriose-based polymer and drying them. "Although conventional drying processes carried out at a reduced pressure and a temperature below 30° C are feasible in the invention, freeze-drying is desirable." Col. 2, lines 52-56.

Thus, Koyama suggests drying under vacuum at temperatures up to 30° C. Even though Koyama prefers freeze-drying, "all disclosures of the prior art, including unpreferred embodiments, must be considered." Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989). I therefore agree that Koyama reasonably suggests methods and compositions encompassed by claims 55, 56, 59, 60, 64, and 67.

However, I cannot agree that Koyama anticipates claim 26. Claim 26 is directed to a "glassy state composition." Appellants' specification defines a glass as follows:

A glass is defined as an undercooled liquid with a very high viscosity, that is to say at least 10^{13} Pa.s, probably 10^{14} Pa.s or more.

Normally a glass presents the appearance of a homogeneous, transparent, brittle solid which can be ground or milled to a powder. In a glass, diffusive processes take place at extremely low rates,

such as microns per year. Chemical or biochemical changes including more than one reacting moiety are practically inhibited.

Above a temperature known as the glass transition temperature T_g , the viscosity drops rapidly and the glass turns into a rubber, then into a deformable plastic which at even higher temperatures turns into a fluid.

Col. 3, lines 52-64.

"[T]o hold that a prior art reference anticipates a claim, the Board must expressly find that every limitation in the claim was identically shown in the single reference." Gechter v. Davidson, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997). The limitations can be disclosed expressly or inherently. See Verdegaaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Koyama does not exemplify any compositions dried under conditions other than freeze-drying: in all of Koyama's examples, a protein is mixed with a polymer and freeze-dried. See, e.g., col. 3, lines 41-45 (interferon was mixed with various stabilizers, "freeze-dried, and stored at either 4° C or 37° C"). The majority concedes that "Koyama does not use the term 'glassy state' to characterize his dry composition." That is, Koyama does not expressly disclose a "glassy state" composition. Therefore, to find that Koyama anticipates claim 26, the examiner and the majority must have concluded that freeze-drying inherently produces a glassy state composition.

If freeze-dried protein/polysaccharide compositions are inherently in a glassy state, claim 26 is anticipated. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) ("When the claimed compositions are not

novel they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in the prior art.”).

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirt v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)).

Anticipation, like any USPTO holding of unpatentability, must be established by a preponderance of the evidence. See, e.g., In re Oetiker, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (J. Plager, concurring: “In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence.”). In this case, that means that the greater weight of the evidence in the record must support a conclusion that the limitation is inherent.

What evidence is cited by the examiner and the majority to show that Koyama’s freeze-dried compositions are inherently in a glassy state? The examiner relies on the “similarity in the components of the compositions and the retained activity of the compositions.” Examiner’s Answer, sentence bridging pages 4 and 5. The majority seems to rely on the same factors. Thus, as I understand it, the examiner and the majority rely on the following evidence:

- (1) Both Koyama’s composition and the composition of claim 26 can contain a protein and a maltotriose-based polysaccharide;
- (2) both compositions are dried; and

(3) both are storage-stable.

I do not agree that the evidence of record is adequate to show that Koyama's compositions are inherently in a glassy state. The instant specification discusses freeze-drying as a known technique for stabilizing proteins. See col. 1, lines 49-66:

The commonest method for the stabilisation of isolated protein preparations is freeze-drying. . . . The aqueous isolate of the active material in a suitable pH buffer and in the presence of a cryoprotectant is first frozen, typically to -40° to -50° C.; the ice is then removed by sublimation under vacuum and at low sub-zero temperatures, following which the residual moisture which may amount up to 50% of the "dried" preparation is removed by desorption during which the temperature gradually rises. . . . Exposure [of the freeze-dried protein] to ambient temperatures for periods of days to weeks can result in significant activity losses.

The specification goes on to distinguish the disclosed method of making glassy state compositions from freeze-drying. See col. 2, lines 21-23 ("There would furthermore be advantage in providing a more cost effective process than the current freeze-drying process.") and col. 2, lines 60-61 ("A further feature is that the process is energy efficient, requiring much less energy than freeze-drying."). The specification also distinguishes between the compositions resulting from the disclosed method and from freeze drying. See col. 4, lines 23-29 ("[I]f the T_g of the composition is close to or below room temperature it may be necessary or desirable to refrigerate the glassy composition if storage is for a prolonged period. This is less convenient but still is more economical than freeze-drying.").

Appellants' specification discloses two methods of making glassy state compositions. Koyama's process is more similar to the second of the two

processes (col. 6, lines 29-58). In that process, the active material (e.g., protein) is mixed with the carrier substance (e.g., polysaccharide) and the resulting solution is divided into smaller aliquots. These aliquots are then dried under reduced pressure "at a temperature not exceeding 40° C, preferably in the range of 20 to 30° C . . . for some hours, for instance 24 to 36 hours." The specification provides an example of applying this process to a composition containing lactate dehydrogenase and several different carriers, including dextran. See Example 13 (column 13). In that example, the enzyme- and dextran-containing composition showed 102% residual activity after 8 weeks at 25° C. See the table in col. 13. Koyama's Example 1-B shows that a freeze-dried composition containing dextran and human interferon retained only 81.5% activity after two months at 4° C and 65.3% activity after two months at 37° C. See Table I.

The majority plays down the significance of the 8-week measurements disclosed in Appellants' specification, focusing instead on the activity measurements at other time points and finding it "curious" that neither Appellants nor I discuss the activity measured at weeks 2 and 4. The reason for that is simple – Koyama only measured residual activity after 2 months' storage. The only data in the specification that can be meaningfully compared to the prior art, therefore, are the 8-week storage data.

In sum, the evidence shows that Appellants' specification describes the disclosed process of making glassy state compositions as an alternative to, and therefore different from, freeze-drying. Appellants' specification also describes

glassy state compositions as stable when stored at room temperature and therefore "more economical than freeze-drying" which requires storage at -20°

C. Finally, Appellants' specification shows that a glassy state composition containing a protein and dextran is more stable at room temperature (25° C) than a freeze-dried one is when stored refrigerated (4° C). I do not agree that a preponderance of the evidence in the record supports the conclusion that Koyama's composition is inherently in a glassy state. Therefore, it is premature to shift the burden of proof to applicants and make them show that the claimed composition differs from those in the prior art. I would reverse the rejection under 35 U.S.C. § 102.


Eric Grimes
Administrative Patent Judge

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) APPEALS AND
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)
) INTERFERENCES

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
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Rick Neifeld

From: Rick Neifeld
Sent: Friday, September 26, 2008 4:03 PM
To: Steve Greenfield (Steven.Greenfield@catalinamarketing.com)
Cc: Rick Neifeld
Subject: RE: Input_CAT29USSCROC03_9-25-2008

Steve - Thank you for confirming just now that these assertions are accurate. RICK

From: Rick Neifeld
Sent: Thursday, September 25, 2008 5:10 PM
To: Francine Hewes
Cc: Carol Chapman; Rick Neifeld; Steve Greenfield (Steven.Greenfield@catalinamarketing.com)
Subject: Input_CAT29USSCROC03_9-25-2008

NEIFELD REF: CAT29US-SCRCO3

Fran - There is an office action pending in this application. (This is an unusual case in that I need to prepare a draft response before commenting on the office action, -- the examiner is Janvier and [redacted].)

I spoke with Steve Greenfield earlier today regarding this application in view of technical issues involved in my draft response. My draft comments in view of discussions with Steve's appear below. However, I need to speak with him again to see if he agrees or has further comments now that they are in writing and revise accordingly.

Steve - Sorry for the additional imposition, but I need to be sure assertions are accurate, particularly if I am going to be allowed by you to use your name in a draft response! Thanks, RICK

"The examiner's conclusion that there is no utility to having two separate database files, as claimed, is incorrect. In this regard, the specification is relevant. The specification states at page 9 lines 24-26 that "the consumer 25 will be required to *enter a valid Internet address for electronic mail (E-mail), and to select a supermarket in his or her area*, as indicated in block 42." and at page 20 lines 9-14 that "Customers who volunteer the necessary linkage in the form of their 10 customer id. may be rewarded in some manner. The customer id. may be requested only once and then used for all subsequent sessions in which the customer logs in to the system. Once the linkage is established, the *consumer purchase history data or targeted incentives needed to support this capability of the invention are periodically transferred from the shopper purchase history system to the on-line system of the present invention.*"

The examiner ignores that fact that combining data in a data file for data acquired online from the user and another data file obtained from a retail store presents complications and costs computer processing time. One complication is whether there are matching records with the same consumer identification in the database file generated online by the interaction with the user and the and the purchase history data file received from a particular retailer. How will the system handle combining that data into a single file when for example there are records that do not have a common user identification? Moreover, during the presumably long processing time to combine two data files into a single file including the time to determine and associate records which have a common user identification and store records that do not have a common user identification, how will still perform its other functions, of running the interactive Web site and delivering incentives. Memory limitations are also relevant. When combining data into a single file memory size limitations are generally a constraint. Combining data files is impacted by the physical memory size (number of bits of storage) and logical size constraints (number of bits referencable in an operating system) and heirarchical limitations (number of data objects at any level that may be efficiently referenced, such

as the number of files in a folder). These details are often non obvious but real and substantive constraints, particularly in large databases. The undersigned discussed this issue with Steve Greenfield of Catalina on 9-25-2008, via telephone. Mr. Greenfield is a person knowledgeable on software and database structure issues, and very familiar with Catalina's systems relying there upon. Mr. Greenfield confirmed to the undersigned that there were significant differences between one or two database files of the type disclosed in the specification and that the issues raised in this paragraph are real.

The examiner has not considered, and this is probative that one of ordinary skill in the art, would not have considered in view of the teachings in Barnett and Shane, these issues. Therefore, it appears that (1) there are reasons why "integrated database file 42 of fig. 6 or into two separate database files... does ... impact the functionality or utility of the method or system." Moreover, the examiner's statements on the record are probative that such reasons would not have been recognized by one skilled in the art, which indicates that the claim including the claimed database structure, expressly claiming two databases, would not have been obvious."

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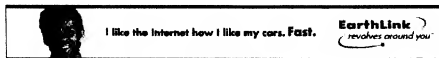


internet address

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3 entries found for *internet address*.

internet address

<networking> (IP address, TCP/IP address) The 32-bit host address defined by the Internet Protocol in STD 5, RFC 791. It is usually represented in dotted decimal notation.

A host's Internet address is sometimes related to its Ethernet address. The Internet address is usually expressed in dot notation, e.g. 128.121.4.5. The address can be split into a network number (or network address) and a host number unique to each host on the network and sometimes also

a subnet address. The way the address is split depends on its "class", A, B or C as determined by the high address bits:

Class A - high bit 0, 7-bit network number, 24-bit host number. n1.a.a.a 0 <= n1 <= 127

Class B - high 2 bits 10, 14-bit network number, 16-bit host number. n1.n2.a.a 128 <= n1 <= 191

Class C - high 3 bits 110, 21-bit network number, 8-bit host number. n1.n2.n3.a 192 <= n1 <= 223

The Internet address must be translated into an Ethernet address by either ARP or constant mapping.

The term is sometimes used incorrectly to refer to a host's

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fully qualified domain name.

[Jargon File]

(1994-12-06)

Source: *The Free On-line Dictionary of Computing*, © 1993-2004 Denis Howe

internet address

<networking> (Note lower case "i"). An IP address that uniquely identifies a node on an internet.

[Jargon File]

(1995-04-12)

Source: *The Free On-line Dictionary of Computing*, © 1993-2004 Denis Howe

internet address

n. 1. [techspeak] An absolute network address of the form foo@bar.baz, where foo is a user name, bar is a sitename, and baz is a 'domain' name, possibly including periods itself. Contrast with bang path; see also the network and network address. All Internet machines and most UUCP sites can now resolve these addresses, thanks to a large amount of behind-the-scenes magic and PD software written since 1980 or so. See also bang path, domainist. 2. More loosely, any network address reachable through Internet; this includes bang path addresses and some internal corporate and government networks.

Reading Internet addresses is something of an art. Here are the four most important top-level functional Internet domains followed by a selection of geographical domains:

com

**What's
wrong with
this
toenail?**



- ☐ Damaged.
- ☐ Active, live infection.
- ☐ Nothing.



commercial organizations

edu

educational institutions

gov

U.S. government civilian sites

mil

U.S. military sites

Note that most of the sites in the com and edu domains are in the U.S. or Canada.

us

sites in the U.S. outside the functional domains

su

sites in the ex-Soviet Union (see [kremvax](#)).

uk

sites in the United Kingdom

Within the us domain, there are subdomains for the fifty states, each generally with a name identical to the state's postal abbreviation. Within the uk domain, there is an ac subdomain for academic sites and a co domain for commercial ones. Other top-level domains may be divided up in similar ways.

Source: Jargon File 4.2.0

Perform a new search, or try your search for "internet address" at:

- [Amazon.com](#) - Shop for books, music and more
- [Reference.com](#) - Search the Web
- [eLibrary](#) - Search thousands of newspapers and magazines
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8-19-04
EB

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, ✓
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-1420 ✓
Application No. 09/567,274 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the twice-rejected claims

28-43.¹

¹The statement of the 35 U.S.C. § 103 rejection in both the answer and in Paper No. 19 indicates that the claims subject to this rejection are claims "34-43" with no indication that claims 28-33 have been rejected on this ground. However, since the body of the rejection in both the answer and in Paper No. 19 then goes on to indicate why claims 28-33 are rejected under 35 U.S.C. § 103, and appellants, by their arguments, clearly understand all

Dec App CAT29SCROOD3-040819 EB

The invention relates to providing shopping incentives to customers through a computer network.

Representative of the sixteen independent claims is claim 28, reproduced as follows:

28. A method for distributing purchasing incentives to retail consumers over a computer network, said method comprising the steps of:

storing product purchase data pertaining to products purchased in association with an identification in a consumer purchase history database;

storing an electronic mail address in association with said identification in a consumer electronic address database;

generating a purchase incentive in response to said identification being provided over said computer network, based on said product purchase data and depending upon frequency of prior use of purchase incentives generated for said identification; and

transmitting said purchase incentive to said electronic mail address.

The examiner relies on the following reference:

Barnett et al. (Barnett) 6,336,099 Jan. 1, 2002
(eff. filing date of Apr. 13, 1995)

of claims 28-43 to stand rejected under 35 U.S.C. § 103, we will treat claims 28-43 as standing twice rejected under 35 U.S.C. § 103 and on appeal herein.

Claims 28-43 stand rejected under 35 U.S.C. § 103 as unpatentable over Barnett.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fina, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

It is the examiner's position, with regard to instant claims 34, 35, 38 and 39, that Figure 1 of Barnett is indicative of a system for distributing purchasing incentives to retail customers over a computer network wherein a database is configured to store product purchase data pertaining to products purchased in association with an identification in a consumer purchase history

database; and that Figure 9 and column 9, lines 59-67, teach a generation of an incentive based upon whether a signal containing the identification was received in a selected prior time period.

The examiner also indicates that Barnett teaches the storing of an electronic mail address in association with said identification in a consumer electronic database at column 13, lines 58-67. However, the examiner indicates that Barnett does not specifically teach transmitting the incentives to the electronic mail address. But, since "the e-mail address for the user is stored...it would have been obvious...to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user (col. 4, lines 25-29)" (answer-page 3).

Specifically, with regard to claims 28, 29, 32, 33, 40 and 41, the examiner finds that purchase incentives generated based upon frequency of redemption of online purchase incentives generated for said identification (see page 4 of the answer) would have been obvious in view of Barnett's disclosure at (Figures 1-9 and column 7, lines 35-55).

The examiner cites Figure 9 of Barnett as evidence of the obviousness of the limitations of claims 30 and 31 and the

examiner cites Figures 1 and 9 of Barnett as evidence of the obviousness of the limitations of claims 36, 37, 42 and 43.

Appellants' position, with regard to claims 28, 29, 32 and 33 is that Figures 1-9 and column 7, lines 35-55 of Barnett do not disclose the claimed "generating said purchase incentive...based upon frequency of prior use of purchase incentives generated for said identification."

With regard to claims 30 and 31, appellants argue that Figure 9 of Barnett does not disclose the claimed "generating said purchase incentive for said identification based upon a frequency of prior use of an online system with said identification."

With regard to claims 34 and 35, appellants argue that Figure 9 of Barnett, column 6, lines 62-66, which describes this figure, and column 9, lines 59-67, do not disclose "generating an incentive based upon whether a signal containing said identification was received in a selected prior time period..."

With regard to claims 36 and 37, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive based on said product purchase data including whether said identification is associated with redemption of an online purchase incentive during a selected prior time period..."

With regard to claims 38 and 39, appellants argue that Figure 9 and column 9, lines 59-67, of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network, based at least in part upon frequency of selection of purchase incentives generated for said identification."

With regard to claims 40 and 41, appellants argue that Barnett does not disclose the concept of generating a purchase incentive at least in part on frequency of redemptions of online purchases generated for an identification.

With regard to claims 42 and 43, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network and based at least in part upon whether said identification is associated with selection of an online purchase incentive during a selected prior time period..."

With regard to all of the claims, 28-43, appellants argue that column 13, lines 58-67, of Barnett, does not disclose "storing an electronic mail address in association with said identification in a consumer electronic database." It is appellants' view that it would not have been obvious to store an electronic mail address in association with said identification

in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

We AFFIRM.

It appears to us that the examiner has set forth a reasonable case, identifying claim limitations and pointing out where, in the reference, such limitations can be found or why the claimed subject matter would have been obvious in view of specific teachings of Barnett. Thus, we find that the examiner has established a prima facie case of obviousness.

Yet, appellants' main response is that Barnett "does not disclose" some limitation quoted from the claims. However, appellants do not explain why they take these positions in view of the examiner's rationale. It is not enough for appellants to merely state that the reference does not disclose something when the examiner has pointed out where and how the reference is considered to have disclosed something or to have made that something obvious. 37 CFR 1.192(c)(8)(iv) requires appellants' arguments to "specify the errors in the rejection and, if

appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art" (emphasis added).

Appellants get somewhat specific with regard to the storing of an electronic mail address in association with said identification in a consumer electronic database by arguing that it would not have been obvious to store an electronic mail address in association with said identification in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

However, we agree with the examiner that while Barnett may not specifically teach the claimed storing of an electronic mail address in association with said identification in a consumer electronic database, it would have been obvious to do so. This is so because Barnett clearly teaches storing a user's e-mail Internet address (column 13, lines 62-65) and since the online

system maintains the user's e-mail Internet address, it would have been clearly obvious to associate a particular user with his/her particular e-mail address and to use such address for any desired transmission to a user.

We note that appellants do not address the obviousness of providing for the claimed storing of an electronic mail address in association with said identification in a consumer electronic database. They merely argue that the reference does not disclose this. It should be noted that this is not an anticipation rejection based on 35 U.S.C. 102, but rather an obviousness rejection based on 35 U.S.C. § 103. Accordingly, the mere allegation by appellants that the applied reference does not disclose a particular claim limitation is not dispositive of the issue of obviousness. Appellants must explain, in view of the examiner's reasonable rationale, why the claimed subject matter would not have been obvious, i.e., appellants must point out the alleged errors in the rejection. This, appellants have not done.

In the reply brief, appellants get more specific regarding the argument that the reference does not disclose the "frequency" limitation. That is, in reviewing column 7, lines 35-55, of Barnett, appellants argue that while the coupon distribution center 16 utilizes the user-specific redemption data, along with

user-specific demographic data supplied by the online service provider 2, this passage does not disclose generating a purchase incentive based at least in part upon frequency of use or redemption of incentives.

We agree with appellants that Barnett does not specifically disclose generating the incentive based at least in part upon frequency of use or redemption. But, again, the rejection is based on obviousness under 35 U.S.C. § 103, rather than anticipation. The reference does not need to specifically disclose the generation of incentives based at least in part upon frequency of use or redemption, as long as there is some suggestion to do so or something that would have led the artisan to base the incentive generation at least in part upon frequency of use or redemption.

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic

data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.

Accordingly, appellants' arguments are not persuasive of unobviousness and fail to overcome the prima facie case of obviousness established by the examiner.

The examiner's decision rejecting claims 28-43 under 35 U.S.C. § 103 is affirmed.

Appeal No. 2004-1420

Application No. 09/567,274

§ 1.136(a).

AFFIRMED

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES

EK/RWK

Appeal No. 2004-1420
Application No. 09/567,274

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

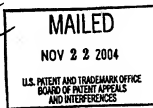
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Atty Review: 12-9-04

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA, ✓
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0989 ✓
Application No. 09/401,939 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-70.

The invention is directed to providing shopping aids and incentives to customers through a computer network. In particular, purchasing incentives are distributed to a consumer by transmitting promotion data identifying a plurality of product

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discounts from a main computer to the consumer's computer and displaying the plurality of product discounts at the consumer's computer based on the promotion data. Selection data designating at least one product discount selected from the plurality of product discounts is then transmitted from the consumer's computer to the main computer.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

The examiner relies on the following references:

Day et al. (Day)	5,857,175	Jan. 5, 1999
Scroggie et al. (Scroggie)	5,970,469	Oct. 19, 1999 (filed Mar. 26, 1996)

Claims 32-70 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as relying on a disclosure lacking enablement and a written description, and as being vague and indefinite.

Claims 32-70 stand further rejected under 35 U.S.C. § 102(b) as anticipated by Day.

Claims 32-70 stand further rejected under 35 U.S.C. § 103 as "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike" (answer-page 5).

Claims 32-70 stand still further rejected under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469 to Scroggie.

Claims 32-70 stand even still further rejected under 35 U.S.C. § 103 "over copending US Patent Application 09/567,274" (answer-page 8).¹

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We turn, first, to the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph.

The examiner contends that the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are "not enabled by the specification." The examiner also contends that the inventors did not have possession of the claimed invention at the time of filing because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to

¹While the examiner indicates the rejection is based on "prior art" in stating that the rejection is under "35 U.S.C. § 103, it is clear from the examiner's explanation, especially, at the bottom of page 15 in the answer, that the rejection is really a provisional rejection based on obviousness-type double patenting.

a main computer over a computer network and generating token data depending on selection data.

It is the examiner's position that these claimed features are not enabled by the instant specification since the "examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention" such that skilled artisans could make and use the invention.

The examiner's position regarding the rejection of the claims under 35 U.S.C. § 112, first paragraph, is unreasonable and we will not sustain these rejections.

As a matter of Patent and Trademark Office practice, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of 35 U.S.C. 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching

contained in the specification is truly enabling, In re Marzocchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971); In re Sichert, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977).

When a rejection is made on the basis that the disclosure lacks enablement, it is incumbent upon the examiner to explain why he doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions with acceptable evidence or reasoning which is inconsistent with the contested statement. The examiner has not advanced any such evidence or an acceptable line of reasoning inconsistent with enablement and, therefore, has not sustained his burden.

Not only has the examiner not set forth any reasonable basis for challenging the sufficiency of disclosure, asserting, without explanation, that he deems the claimed features to be merely "concepts that cannot be practically applied" (answer-page 4), but it appears to us that the claimed features of "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" merely entail programming web sites to provide the functionality claimed. This functionality of transmitting data selected from a plurality of

choices and generating other data in dependence on the selection data does not appear to us to be anything out of the ordinary for the skilled web programmer and would not entail any undue experimentation on his/her part.

Accordingly, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph, based on non-enablement.

With regard to written description, we also will not sustain the rejection of claims 32-70 on this ground.

The examiner again points to the claim language, "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" and, now, alleges that since the specification does not discuss these claimed features, it is not considered that the applicants had possession of what they now claim as their invention at the time of filing the instant application.

Appellants point to page 9, lines 4-5, of the instant specification for a disclosure of a customer selecting a coupon offer from a plurality of offers after log-in and switching to an offer browser.

With regard to "generating token data...", appellants point to page 24, lines 2-6, of the specification. Since this portion of the specification states that

Generating a "token" instead of coupon, as described above with reference to FIG. 13, also reduces the risk of fraud. Another technique similar to this is depicted in FIG. 18. A token 316 is generated by the user's computer 302 after interaction with the distribution server 300. The user chooses from incentive offers as described above, but instead of a coupon the computer 302 generates the token 316,

it is clear to us that applicants did, indeed, have possession of the invention which they now claim.

Thus, we will not sustain the rejection of claims 32-70 under the written description clause of 35 U.S.C. § 112, first paragraph.

Turning to the rejection of the claims under 35 U.S.C. § 112, second paragraph, the examiner alleges that the claims are indefinite because there is no antecedent basis for "transmitting selected data" or "generating token data" in the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network and generating token data depending on said selection data. The examiner also alleges that the instant specification also does

not provide an antecedent basis for these claim limitations.

First, we point out that the second paragraph of 35 U.S.C. § 112 is directed to the claims, not the specification. We may look to the specification to give meaning to an otherwise misunderstood claim limitation but the claims themselves must provide the antecedent basis for the specific claimed steps/elements.

Moreover, the inquiry under 35 U.S.C. 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In the instant case, taking claim 32 as exemplary, the steps of "transmitting selection data..." and "generating a token data..." are first time recitations within the claim and the recited steps themselves provide the antecedent basis for the steps. Thus, the examiner's concern for "antecedent basis" is not understood. It is not as if the claims recited "said step of

transmitting selection data..." and never previously recited such data.

Accordingly, we find that the examiner's rejection under 35 U.S.C. § 112, second paragraph, has no basis, in fact. The claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity and, as such, are in accordance with 35 U.S.C. § 112, second paragraph. The examiner has failed to reasonably show any indefiniteness within the claims.

Thus, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, second paragraph.

The examiner's next rejection deals with anticipation of the claims under 35 U.S.C. § 102(b) over Day.

A claim is anticipated only when a single prior art reference expressly or inherently discloses each and every element or step thereof. Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). If the examiner presents a reasonable basis for alleging inherency, the burden shifts to appellant to come forward, if they can, with evidence to the contrary. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Ludtke, 441

F.2d 660, 169 USPQ 563 (CCPA 1971); In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

It is the examiner's position that claims 32-70 are "clearly anticipated" by Day, without any explanation in the statement of the rejection at page 5 of the answer.

In response to appellants' arguments, the examiner explains his position, at pages 11-14 of the answer. That position is that column 1, line 64 through column 2, line 5, and column 3, line 20, anticipates all of the claimed subject matter with regard to the independent claims.

The examiner basically relies on the background section of Day, wherein is described an in-store terminal which a consumer may access. A list of coupons is presented to the consumer, and a link between the terminal and check-out stations in the store permits discounts selected by the consumer to be subtracted from the total bill on check-out.

We would agree that, given the broadest, reasonable interpretation of "personal computer," "computer network" and "main computer," one might consider the in-store terminal described in Day as a "personal computer" since it is used by the consumer. One may even consider the link between the terminal and the check-out stations to be part of a "computer network."

Possibly, the main check-out stations might constitute the claimed "main computer."

However, it is not clear from the description in Day, or from the examiner's explanation, that the main computers (i.e., the main check-out stations) are actually transferring the promotion data to the personal computer (i.e., the consumer terminals). The instant claims require the main computer to transfer promotion data identifying a plurality of product discounts to a personal computer over a computer network.

But, even if we assume that the check-out stations described in the cited portions of Day do, in fact, transmit the promotion data to the customer terminal and even if we assume, then, that Day would teach the claimed steps of "transmitting promotion data...", "displaying said plurality of product discounts..." and "transmitting selection data...", the examiner's case would still fail because the instant claims all require an element/step of "generating token data depending on said selection data."

The examiner's rationale is that this generation of token data is "considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the

disclosed discount subtraction" (answer-page 12), referring to lines 3-4 of column 2 in Day.

The cited portion of Day refers to "discounts selected by the consumer." This may be equivalent to the claimed "...at least one product discount selected..." in the "transmitting selection data..." paragraph of claim 32, for example. But, this cited portion of Day cannot then also serve as disclosing the next claimed step of "generating token data depending on said selection data" because it is only after the selection is made that a token, depending on said selection data, can be generated.

Moreover, we do not see how the generation of such token data can be "implicit" as urged by the examiner.

The examiner has pointed to nothing in the Day disclosure which even suggests the claimed generation of "token data." Without a teaching of this token data, Day cannot identify any such token data or determine discount items being purchased from undisclosed token data.

Accordingly, since the examiner's rationale fails to convincingly point, in the applied reference, to the claimed "token data," the examiner has failed to establish a prima facie case of anticipation and we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 102(b).

We do point out, in passing, however, that should the examiner have convinced us of a teaching of such "token data" in Day, appellants' arguments would have been insufficient to overcome such a prima facie case since appellants merely argue that Day does not disclose what is recited in the claims, without specifically pointing out any perceived errors in the examiner's position, and without specifically identifying particular claimed features which are considered to distinguish over Day.

Nevertheless, since the burden to establish a prima facie case of anticipation rests initially on the examiner, and, in our view, the examiner clearly failed to meet that burden in this case, we do not reach appellants' arguments.

The examiner's next rejection, under 35 U.S.C. § 103, is based on "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike."

The examiner contends that since "at least 1994, PerformanceBike has performed the claimed method, system and program..." The examiner states that he

has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token

use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased... The claimed invention...has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known...to claim the invention as recited by the applicant by substituting terms with patentably equivalent claim language, in order to overcome the explicit teachings of the examiner's experienced prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious...to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known... It is considered that the claim recitations using "computer" are an attempt to automate an old and well known process provided by PerformanceBike... (answer-pages 6-7).

Appellants argue, at pages 15-20 of the principal brief, that the PerformanceBike website has not been established as

Appeal No. 2004-0989
Application No. 09/401,939

prior art and the examiner has offered no physical evidence to support the examiner's assertions.

We have considered the examiner's assertions and appellants' arguments thereagainst and we conclude that the examiner has simply not established that his experience with PerformanceBike would constitute a prima facie case of obviousness against the instant claimed subject matter. Without physical evidence and/or a more detailed written description as to how the PerformanceBike retail system works, we are not persuaded by the examiner's declaration of experience that the frequent buyer card bar code number would read on the generating, transmitting and identifying steps in paragraphs 5-7, for example, of claim 32, or that a red courtesy phone may be considered the claimed "personal computer." We are also not convinced that the claimed transmitting promotion data would be met by merely walking into a PerformanceBike retail store so that the information is "transmitted" to the consumer.

Since the examiner's experience is not convincing as to obviousness of the instant claimed subject matter, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 103 based on the examiner's experience with PerformanceBike.

The examiner also rejected claims 32-70 under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

As the examiner explained, at page 8 of the answer, while the claims are not identical, they are not patentably distinct from each other because "the patented feature of encoded data is an obvious variation of the application claimed token and because both perform the same function in the same manner with the same result."

It is our view that the examiner makes at least a reasonable case since the "token" of the instant claims does appear to be similar to the patented "purchasing incentive containing in encoded form the identity of the retailer designated by the customer..." In the face of this rather reasonable finding of obvious-type double patenting, appellants' sole argument is that the patented claims

define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other (principal brief-page 22).

Thus, appellants merely assert that the instant claims would not have been obvious over the patented claims but do not point to any error in the examiner's reasoning. It is not enough to

argue that the instant claims define identifying token data in a retail store when the patented claims are also clearly directed to generating purchase incentives for a retail store. Appellants have offered nothing to show any non-obviousness difference between the claimed "token" and the encoded purchasing incentive, while the examiner has made out a reasonable case that one would have been obvious over the other.

Accordingly, we will sustain the rejection of claims 32-70 over obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

Finally, we turn to the examiner's rejection of the claims "under 35 U.S.C. § 103(a) as being obvious over copending US Patent Application 09/567,274," which, as explained supra, is really a provisional rejection based on obviousness-type double patenting.

It appears to be the examiner's position that the difference between the instant claims and the claims in the copending application is in the recitation, by the latter, of the generation of redeemable vouchers, separate shopping list transmission, etc. and that the instant claims would have been obvious thereover, especially since the instant claims appear to be broader in scope.

The examiner's position does not appear to be unreasonable. Yet, appellants do not dispute the merits of the rejection. Instead, they argue only that the copending application is not prior art because it "appears from the PTO website to be unpublished" (principal brief-page 24). Appellants appear to be responding to a rejection thought to be under 35 U.S.C. § 103. However, the examiner made it clear, in the response section of the answer, that this rejection was really a provisional obviousness-type double patenting rejection. In filing a reply brief, appellants had an opportunity to respond to this rejection but, for whatever reason, chose not to do so. Thus, in effect, we have no response from appellants with regard to the rejection.

If the copending application has been, or will be, abandoned, then this rejection becomes moot. However, if the copending application remains pending with the claim language identified by the examiner, then this "provisional" rejection appears to us to be proper.

Accordingly, we will sustain this provisional rejection of claims 32-70 over copending application Serial No. 09/567,274, based on obviousness-type double patenting, as appellants have convinced us of no error in the examiner's position.

Appeal No. 2004-0989
Application No. 09/401,939

Rejections which were previously made by the examiner but not repeated in the answer are not before us. Accordingly, contrary to appellants' request, we will not treat such rejections.

CONCLUSION

We have not sustained the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs. We also have not sustained the rejection of claims 32-70 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103 based on an obvious variation of the examiner's personal knowledge of incentives by PerformanceBike.

We have, however, sustained the rejection of claims 32-70 based on obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469, and over claims of copending application Serial No. 09/567,274.

Therefore, the examiner's decision is affirmed.

Appeal No. 2004-0989
Application No. 09/401,939

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 33

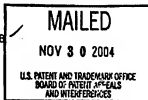
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, /
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738 ✓
Application No. 09/401,198 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-67.

The invention is directed to providing shopping aids to customers through a computer network. In particular, a prompt for personal information from a main computer to a personal computer is transmitted over a network; personal information data

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is transmitted over the network from the personal computer to the main computer responsive to the prompt; page data defining a web page based on the personal information is generated; and a web page address to that web page is assigned.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer over a computer network;

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt;

generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information.

The examiner relies on the following reference:

Angles et al. (Angles)	5,933,811	Aug. 3, 1999
		(filed Aug. 20, 1996)

Claims 32-67 stand rejected under 35 U.S.C. § 103 as unpatentable over Angles.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

The examiner points to Figures 1-3, 7, and 9-11, and column 5, lines 62-67, column 6, lines 4-14, column 7, lines 19-42 and column 8, lines 10-19 and 33-67, of Angles and alleges that while these cited portions of the reference lack "explicit" recitation of all of the elements of the claim, e.g., independent claim 32, it would have been obvious to arrive at the instant claimed subject matter

because such a method supports customization "which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet...In addition, to executing the content provider script, the advertisement provider also obtains the consumer's member code from the consumer computer. The advertisement provider uses the consumer's member code to identify the consumer's demographic profile and preferences..." (See Angles (col. 4, ll. 6-14; and col. 3, ll. 53-65)). (Answer-pages 6-7).

We will sustain the rejection of claims 41-67 under 35 U.S.C. § 103 because the examiner has established a prima facie case of obviousness. We will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 because, in our view, the examiner has not established such a case with regard to the subject matter of these claims.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rietkaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the instant case, the examiner merely alleges that each and every claim limitation is either taught or suggested by Angles or that the claimed subject matter would have been obvious even though the examiner points to not one of the claimed elements/steps having a corresponding teaching in the applied reference. It is unclear from the examiner's explanation, exactly what elements/steps of Angles are considered to correspond to the claimed elements/steps.

It is clear to us that Angles teaches a method of delivering advertisements to a consumer's computer and, in doing so, there is a transmission of a prompt for personal information from a main computer to a personal computer and also a transmission of personal information from the personal computer to the main computer in response to the prompt. It is clear from column 3, lines 18-28, of Angles, that the reference suggests the claimed transmission of a prompt for, and transmission of, personal information data from/to a main computer and a personal computer.

However, the examiner has never explained where, in Angles, is to be found the claimed "generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information."

We note that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyperlinks to other information and that the "hyper-links typically direct the user's Internet browser to access different websites on the Internet." In our view, one may fairly interpret this disclosure as a teaching of "generating page data defining a web page based upon said personal information" since the advertisements sent to a consumer in Angles are based on personal

information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data. But, even if we accept such an interpretation, and we do, this still does not reveal where the claimed limitation of "assigning a web page address to said web page based upon said personal information" is to be found, or suggested, in Angles.

In responding to appellants' arguments, the examiner merely replies with general platitudes regarding the law on obviousness as well as "cogent reasons to modify the teachings of Angles," (answer-page 59). The examiner cites various cases, and various portions of Angles, at pages 58-69 of the answer, but the examiner never offers any specifics as to just how, exactly, specific teachings of Angles are considered to disclose or suggest the specific claim limitations, especially the limitation anent "assigning a web page address..."

Generalities are not sufficient to establish obviousness under 35 U.S.C. § 103. The examiner must give specifics as to how the prior art is applied against the claimed subject matter. "[T]he Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Similarly, the examiner must also make findings based on material facts documented on the record. Yet, the examiner, in this case, has not shown how, in accordance with the record of this case, Angles suggests "assigning a web page address to said web page based upon said personal information." The examiner may not merely allege obviousness, without finding a single claimed element/step in the reference, by stating that the disclosure of Angles "supports customization..."

At page 68 of the answer, the examiner asserts that teachings in an unapplied reference to Legarde anent associating URLs and hyper-links with assigning a web page address to a web page based on personal information, would have been "inherently disclosed in Angles in view of Legarde."

Not only is it not understood how the assigning of a web page address to a web page based on personal information can be "inherent," but the examiner appears to be basing this "inherency," indeed, basing the entire rejection, on a reference which is not even part of the statement of rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the

rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

While there may possibly be some convincing reason why the disclosure in Angles might be considered to obviate the instant claimed subject matter, within the meaning of 35 U.S.C. § 103, by somehow suggesting the claimed "assigning a web page address to said web page based upon said personal information," the examiner clearly has not provided it.

Accordingly, we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 as set forth by the examiner.

With regard to claims 41-67, we will sustain the rejection of these claims under 35 U.S.C. § 103 because these claims do not include the limitation of "assigning a web page address to said web page based upon said personal information." Rather, these claims merely recite the generation of page data defining a web page based on the personal information and the transmission of the page data. As explained, supra, we consider the disclosure of Angles, at column 4, lines 7-9, to suggest such a generation and transmission of page data.

Even where some of the claims, e.g., claim 50, recite a "personalized web page," this is considered suggested by the hyper-links in Angles because these hyper-links lead to a web

page as a result of the personal information. Accordingly, the web pages displayed as a result may be considered "personalized web pages."

In claim 42, there is a step of "communicating a web page address for said web page" recited. However, this is different from the recitation, in claim 32, for example, of "assigning a web page address to said web page" because there is no assignation. Rather, claim 42 merely requires a communication of a web page address for a web page, which may be the web page to which the hyper-link takes the user in Angels. It does not require assigning a web page address to the web page, that was defined by the generation of page data, based upon the personal information.

Accordingly, we will sustain the rejection of claims 41-67 under 35 U.S.C. § 103, but we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103.

The examiner's decision is affirmed-in-part.

Appeal No. 2004-0738
Application No. 09/401,198

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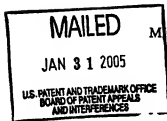
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DHS

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MICHAEL C. SCROGGIE,
MICHAEL E. KACABA, DAVID A. ROCHON
and
DAVID M. DIAMOND

Appeal No. 2004-1420 CAT/29-SCRO-CO3
Application No. 09/567,274

ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we rehear, and reconsider, our decision of August 18, 2004, wherein we sustained the examiner's rejection of claims 28-43 under 35 U.S.C. §103.

In particular, appellants contend that we assumed facts not in evidence as the basis for our conclusion that the examiner had established a prima facie case of obviousness. Moreover, appellants argue that although the examiner has provided no reason as to why the claimed subject matter would have been obvious, our decision merely points to the fact that appellants have not traversed the non-existent reasoning of the examiner, specifically pointing to page 8, line 17, through page 9, line 7 of our decision (see page 5 of the request for rehearing).

Moreover, appellants argue, the examiner did not point out where and how the Barnett reference made the claimed subject matter obvious and, in fact, the examiner's assertions were only sufficient to support an allegation of anticipation, not obviousness (page 5 of the request for rehearing).

We disagree with appellants.

First, it is clear, from page 3 of the answer that the examiner's reasons for rejection of the claims were based on obviousness, and not anticipation. Note that at that portion of the answer, after indicating that Barnett discloses various claimed elements, and where those disclosures may be found within Barnett, the examiner indicates that Barnett "does not specifically teach

transmitting the incentives. . . ." The examiner then goes on to state why the claimed subject matter as a whole would have been obvious, by stating that

[s]ince the e-mail address for the user is stored then it would have been obvious . . . to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user.

While the examiner specifically applied this reasoning to claims 34-43, it is clear that this reasoning is applicable to the other claims since those other claims also include the limitation of transmitting a purchase incentive to an electronic mail address.

Further, while the examiner may not have gone into as much detail as appellants desired in applying Barnett to the specifics of the claims, the examiner did, in fact, set forth a reasonable case of obviousness by indicating how each of the claimed elements is alleged to have been taught by Barnett and why the claimed subject matter would have been obvious thereover. Accordingly, the burden shifted to appellants to overcome the examiner's prima facie case by specifically pointing to some error in the examiner's reasoning.

Yet, instead of pointing specifically to error in the examiner's reasoning and showing how/why Barnett does not teach what is alleged by the examiner, appellants merely cite portions

of the claims and cavalierly contend that Barnett "does not disclose or suggest" the claimed subject matter (e.g., see paragraph d at page 7 of the principal brief) without further explanation.

When confronted with a rejection under 35 U.S.C. §103, an applicant is obliged to specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection. Moreover, the applicant should explain how such limitations render the claimed subject matter unobvious over the prior art. In the instant case, appellants have failed to explain how the cited claim limitations render the claimed subject matter unobvious. It is true that the examiner has the burden, in the first instance, to establish a prima facie case, but, once that case is established, as we hold it was here, appellants must come forward with specific arguments as to why the examiner's rationale is erroneous and why the specific claim limitations render the claimed subject matter unobvious. For the most part, appellants have not done this.

We note that arguments that appellants could have made but, for whatever reason, have not made, are waived. In re Kroekel, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

At page 6 of the request for rehearing, appellants argue that the claim limitation of "generating said purchase incentive based upon frequency of prior use of purchase incentives

generated for said identification" is not taught by Barnett. In particular, appellants argue that Barnett teaches what is stored in the database 11 and those stored elements do not include a time of prior use of a purchase incentive generated for identification.

While appellants are arguing that the "frequency of use" limitation of some of the claims is not taught by Barnett, as we said in our decision, the rejection is not one based on anticipation, but, rather, on obviousness. Therefore, the applied reference need not teach each and every element, including "frequency of use." It is only necessary that the applied reference suggests the claimed subject matter so that the artisan would have been led, from its teaching, to base the incentive generation at least in part upon frequency of use.

As we indicated in our decision at pages 11 and 12:

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more

frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.

Accordingly, we did explain in our decision why the artisan would have been led to the instant claimed subject matter and appellants have not convinced us of any error in our decision.

While appellants now argue that Barnett's teaching of periodic downloading and frequency is the inverse of periodicity, that we misapprehended the examiner's position regarding a "selected time period" and that we rely on facts not in evidence, such as "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered," appellants do not appear to point to any perceived error in our rationale for sustaining the rejections. That is, while appellants argue that we rely on facts not in evidence, appellants do not refute the allegation that "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered." Further, even if, arguendo, we may have applied the

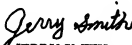
reference in a somewhat different manner than did the examiner, appellants have not convincingly shown any error in our application of the reference.

Accordingly, since, in our view, appellants have not shown any error in our decision, while we grant appellants' request for rehearing to the extent that we have reconsidered our decision, we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED


ERROL A. KRASS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

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Appeal No. 2004-1420
Application 09/567,274

Neifeld IP Law, PC
2001 Jefferson Davis Highway
Arlington, VA 22202

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

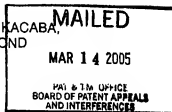
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

CAT/29US-SCROCO

Appeal No. 2004-0989
Application No. 09/401,939



ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants filed a request for rehearing under 37 CFR § 41.52, on January 24, 2005, requesting that we reconsider our decision of November 22, 2004 wherein we sustained the rejection of claims 32-70 based on obviousness-type double patenting. We presume that appellants do not take issue with that part of our decision wherein we did not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103.

DecReqRehear-CAT29USSCROCO_050316

As an initial matter, appellants contend that we are not authorized by 37 CFR § 41.50 to "sustain" or "not sustain" but only to "affirm" or "reverse."

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse, or affirm-in-part, the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On more important matters, appellants contend that with respect to the rejection of claims 32-70 over related case 09/567,294, we overlooked the fact that the examiner presented a new ground of rejection in the answer, which the examiner was not permitted to do under 37 CFR § 1.193, in effect at the time of the answer. Appellants' position is that the examiner's answer, for the first time, presented the rejection as one of provisional obviousness-type double patenting over application Serial No. 09/567,274, in contrast to the final rejection which rejected these claims under 35 U.S.C. §103 as unpatentable over the claims of application Serial No. 09/567,274.

While we have considered appellants' argument, we find no actionable error in our decision. It is true that the examiner based the rejection in issue on "35 U.S.C. §103," but it is also clear from the answer, at page 8, that the examiner was really basing the rejection on "double patenting," as the rejection is listed under that heading. In any event, the rationale has been the same throughout the prosecution (viz., in the

final rejection and in the answer) that the instant claims were not patentably distinguishable from the claims of copending application Serial No. 09/567,274. Moreover, if appellants thought that the examiner was establishing an impermissible new ground of rejection in the answer, appellants could have, and, in fact, did, file a reply brief. Therefore, we fail to see how appellants have been harmed by the examiner's possible error of using "35 U.S.C. §103" in the statement of the rejection. Yet, even though appellants filed a reply brief and, by then, it was clear, or should have been clear, to appellants what the examiner's position was regarding the provisional obviousness-type double patenting rejection, appellants chose, for whatever reason, not to respond to this rejection.

Accordingly, since we find that appellants have shown no actionable error in our decision, while we grant appellants' request to the extent that we have reconsidered our decision, the request is denied with respect to making any changes therein.

Appeal No. 2004-0989
Application No. 09/401,939

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

DENIED


ERROL A. KRASS
Administrative Patent Judge


JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge

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Appeal No. 2004-0989
Application No. 09/401,939

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ARLINGTON VA 22202

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

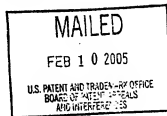
Attorney Review 2/23/05

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738
Application No. 09/401,198

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request a rehearing and reconsideration of that part of our decision of November 30, 2004 wherein we affirmed the examiner's decision rejecting claims 41-67 under 35 U.S.C. § 103. Appellants do not seek rehearing on that part of our decision wherein we reversed the examiner's decision with regard to the rejection of claims 32-40 under 35 U.S.C. § 103.

Treating paragraph II of the request for rehearing first, appellants contend that references in our decision to sustaining or not sustaining a rejection are improper since 37 CFR 41.50 authorizes the board to "affirm" or "reverse" rejections of an examiner, but not to "sustain" or "not sustain" such rejections.

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse or affirm-in-part the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On a matter of more real concern to appellants, they argue that our affirmance of the examiner's decision with regard to claims 41-67 was not based on the same grounds as the examiner's original rejection and, therefore, we should have expressly indicated that we imposed a new ground of rejection under 37 CFR 41.50(b).

In particular, appellants assert that our reasoning that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyperlinks to other

information, that the hyper-links typically direct the user's Internet browser to access different websites on the Internet, and that therefore, Angles suggests "generating page data defining a web page based upon said personal information," is reasoning not relied upon by the examiner and, thus, our rationale for sustaining the rejection of claims 41-67 constitutes a new ground of rejection.

We have reconsidered our decision in view of appellants' comments and we do not believe that our rationale constituted a new ground of rejection. The examiner used essentially the same rationale, at page 6 of the answer, wherein it stated, with regard to the obviousness of the claimed subject matter in view of Angles, that Angles supports customization "*which can contain hyper-liinks to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet. . .*" Thus, it is clear that the examiner was relying on the same rationale as we stated, i.e., that advertisements sent to a consumer's computer may contain hyperlinks to other information, and that these hyperlinks direct the user's Internet browser to access different websites. Thus, if the advertisements, which are sent to a consumer based on personal information, are said to be "page data" (i.e., the

advertisement page contains data including a hyperlink) and the hyperlink (the hyperlink defining a web page since clicking on this hyperlink will send the user to that web page) in that page data is directed to a certain web page, it can be reasonably said that Angles generates page data defining a web page based on personal information, as claimed.

Appellants assert, at page 10 of the request for rehearing, that "a hyper-link is not a web page." It is true that the hyper link is not, itself, a web page, but clicking on the hyperlink results in a direct connection to the web page for which the hyper link is the address. Accordingly, if page data defines a hyper link, by the hyper link's inclusion in that page data, and the hyper link leads directly to a specific web page, then the generated page data may very well be said to define that web page.

Appellants also maintain that our decision does not expressly identify which claims are being discussed when we indicate that the examiner failed to make a prima facie showing, and that our statements in that regard appear to be generic and cover all the allegations in the final rejection and/or the examiner's answer (request for reconsideration-page 11).

While appellants do not identify the portion of the decision to which they refer, we assume appellants are directing the argument to pages 4-7 of our decision. Therein, we do recite various deficiencies in the examiner's case, but it is clear, from page 8 of the decision, below the listing of the deficiencies in the examiner's case, that our prior discussion related to the rejection of claims 32-40, since we summarize by saying, "Accordingly, we will not sustain the rejection of claims 32-40. . . as set forth by the examiner." Immediately, in the next paragraph, we begin to discuss our view of the rejection of claims 41-67. Therefore, a closer reading of the decision shows that we do, indeed, identify only the rejection of claims 32-40 as failing to show a case of prima facie obviousness.

At page 12 of the request for rehearing, appellants argue that our decision does not address the argument at page 7, lines 14-15, of the principal brief, wherein the examiner admitted that Angles does not expressly disclose claimed limitations.

We do not find appellants' argument persuasive. The examiner merely contended that while Angles did not expressly teach each and every element of the claimed subject matter, the claimed subject matter as a whole would have been obvious for the examiner's stated reason. Yet, at page 7 of the principal brief,

to which appellants direct our attention, there is no specific argument by appellants as to what, exactly, is the alleged error in the examiner's case. To merely state that a reference does not teach a certain claimed element, without any explanation as to the reasons deemed by appellants to distinguish the claimed subject matter over the reference disclosure, or as to the alleged errors in the examiner's case, does not constitute a convincing argument for rebutting the examiner's prima facie case.

At page 12 of the request for rehearing, appellants contend that our decision to sustain the rejection of claim 44 is at odds with our factual conclusion that Angles does not disclose or suggest assigning a web page address based upon the personal information. We disagree.

We did not sustain the rejection of the claims reciting "assigning a web page address to said web page based upon said personal information." But claim 44 is directed to the personal information comprising an identity code and that a page address for said web page depends upon said identity code. There is no direct recitation, in claim 44, of "assigning" the address for the web page based on the personal information. Thus, we find no

inconsistency between our finding with regard to claim 44 and our finding with regard to claim 32.

At page 12 of the principal brief, appellants further argue that we misapprehended or overlooked the argument at page 9 of the principal brief, relating to the purchase history database, and that we misapprehended the examiner's incorrect conclusion regarding claim 46, that Angles' storage of a cookie containing a consumer's ID on a user's computer suggests "storing in a purchase history database data identifying products purchased in association with said identity code."

Again, we found that the examiner established a case of prima facie obviousness, which was not argued by appellants. It is not an argument for appellants to merely recite that a reference does not disclose or suggest a particular claimed feature, when the examiner has indicated that it does, without specifically pointing out the error in the examiner's reasoning. With no argument pointing to an error in the examiner's rationale, we will accept the examiner's finding as being correct. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See 37 CFR § 41.37(c)(1)(vii).


Appeal No. 2004-0738
Application No. 09/401,198

Similarly, appellants' "arguments" at page 9 of the principal brief (see page 13 of the request for rehearing) are not persuasive because they point to claim limitations without any specific argument as to how such limitations allegedly distinguish over the claimed subject matter. These "arguments" fail to point to any specific error in the examiner's rationale. Accordingly, we will accept the examiner's findings as being correct.

We have considered appellant's request for rehearing and reconsidered our decision in view of such request but, remaining unconvinced of any error in our decision, we deny appellants' request anent making any changes in our decision.

Appeal No. 2004-0738
Application No. 09/401,198

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*164 Fed. Appx. 999, *; 2006 U.S. App. LEXIS 4064, ***

IN RE MICHAEL C. SCROGGIE, MICHAEL E. KACABA, DAVID A. ROCHON and DAVID M.
DIAMOND (Real Party In Interest Catalina Marketing Corporation)

05-1353

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

164 Fed. Appx. 999; 2006 U.S. App. LEXIS 4064

February 10, 2006, Decided
February 10, 2006, Filed

NOTICE: [1]** RULES OF THE FEDERAL CIRCUIT COURT OF APPEALS MAY LIMIT CITATION TO UNPUBLISHED OPINIONS. PLEASE REFER TO THE RULES OF THE UNITED STATES COURT OF APPEALS FOR THIS CIRCUIT.

PRIOR HISTORY: ON APPEAL from the PATENT & TRADEMARK OFFICE BOARD OF PATENT APPEALS & INTERFERENCES. (Serial No. 09/567,274).

JUDGES: MAYER, RADER, and PROST, Circuit Judges.


OPINION: [*999] Judgment

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam:

AFFIRMED. See *Fed. Cir. R.* 36.

Source: [My Sources > Federal Legal - U.S. > Federal Court Cases, Combined](#) 
Terms: [05-1353](#) ([Edit Search](#) | [Suggest Terms for My Search](#))

View: Full

Date/Time: Monday, September 25, 2006 - 2:32 PM EDT



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Appendix III - Related Proceedings 8

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition
is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

05-1370 ✓
(Serial No. 09/401,198) ✓

CAT/29US-SCRODI

IN RE MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND
(Real Party Interest Catalina Marketing Corporation)

DECIDED: March 13, 2006

Before MAYER, RADER, and PROST, Circuit Judges.

Opinion for the court filed by Circuit Judge PROST. Opinion concurring-in-part and dissenting-in-part filed by Circuit Judge MAYER.

PROST, Circuit Judge.

Michael C. Scroggie, Michael E. Kacaba, David A. Rochon, and David M. Diamond (collectively, "Scroggie") appeal a decision by the United States Patent and Trademark Office Board of Patent Appeals and Interferences (the "Board") affirming the final rejection of claims 41-67 of U.S. Patent Application Serial No. 09/401,198 (the

"198 application") as obvious under 35 U.S.C. § 103 in view of a single prior art reference, U.S. Patent No. 5,933,811 ("Angles"). Ex parte Scroggie, Appeal No. 2004-0738, Paper No. 33 (B.P.A.I. Nov. 30, 2004) ("Board Decision"). Because the Board erred in construing the term "generating page data" in claims 41-49, we reverse the Board's decision with respect to those claims, but because the Board correctly construed the term "personalized web page" in claims 50-67, we affirm the Board's decision with respect to those claims.

BACKGROUND

On September 23, 1999, Scroggie filed the '198 application. The claims of the '198 application are generally directed to a system and method for generating a web page. In claims 41-49, "generating page data" is both a limitation of the claims and a part of the preamble, whereas for claims 50-67, "generating a web page" is only part of the preamble. Additionally, claims 50-67 contain the limitation "personalized web page." Claims 41 and 50 are representative with respect to each of those limitations which are the focus of the parties' dispute in this case.

41. A computer implemented method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer over a computer network;

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt; and

generating page data defining a web page based upon said personal information data.

50. A computer method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer;

receiving at said main computer personal information data transmitted from said personal computer; and

transmitting from said main computer to said personal computer web page data for displaying a personalized web page, said personalized web page based upon said personal information data.

(emphases added).

The '198 application's specification, however, appears to be more narrow than its claims because it is generally directed to a method for sending shopping incentives (e.g., coupons) to customers over the Internet. The coupons can be transmitted to the customer in various ways, including by e-mail and by embedding the coupons in a web page. The coupons can then be printed by the customer and used at retail stores.

In the decision on appeal, the Board relied solely on Angles as establishing a prima facie case of obviousness of claims 41-67.¹ In general, Angles discloses a system and method for delivering customized electronic advertisements in an interactive communication system. The Board found that the first two elements of representative claim 41, i.e., the two transmitting steps, were clearly taught or suggested by Angles. Scroggie does not disagree. Additionally, the Board found that the examiner had not explained where, in Angles, the third element, "generating page data defining a web page based upon said personal information data" was either taught or suggested. The Board, however, found that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyper-links to other information and that the "hyper-links typically direct the user's Internet browser to access different websites on

¹ Additionally, the Board found that the examiner's rejection of claims 32-40 was improper because the examiner did not provide a convincing reason why the disclosure in Angles obviated the phrase "assigning a web page address to said web page based upon said personal information," as found in those claims. Therefore, the Board reversed the examiner's rejection with regard to claims 32-40 and therefore, Scroggie has not appealed the Board's decision with respect to those claims.

the Internet." Board Decision, slip op. at 5. Thus, the Board concluded that since the advertisements sent to a consumer in Angles are based on personal information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data, "one may fairly interpret this disclosure as a teaching of 'generating page data defining a web page based upon said personal information.'" Board Decision, slip op. at 8.

In regard to claims 50-67, the Board found that the hyper-links in Angles suggest the "personalized web page" limitation because those hyper-links lead to a web page as a result of personal information. Thus, the Board concluded that the web pages displayed could be considered "personalized web pages" as that term is used in claims 50-67.

On Scroggie's request for rehearing, the Board reaffirmed its conclusion that Angles teaches the third limitation of claim 41, "generating page data defining a web page based upon said personal information." The Board reiterated that "if the advertisements, which are sent to a consumer based on personal information, are said to be 'page data' (i.e., the advertisement page contains data including a hyperlink) and the hyperlink (the hyperlink defining a web page since clicking on this hyperlink will send the user to that web page) in that page data is directed to a certain web page, it can be reasonably said that Angles generates page data defining a web page based on personal information, as claimed." Ex parte Scroggie, Appeal No. 2004-0738, Paper No. 33, slip op. at 3-4 (B.P.A.I. Feb. 10, 2005).

DISCUSSION

Obviousness is a legal question based on underlying factual findings. See e.g., In re Mayne, 104 F.3d 1339, 1341 (Fed. Cir. 1997). What a reference teaches, including whether it teaches toward or away from the claimed invention, is a question of fact. Para-Ordnance Mfg. v. SGS Imps. Int'l., 73 F.3d 1085, 1088 (Fed. Cir. 1995). This court upholds the Board's factual findings unless they are unsupported by substantial evidence. In re Gartside, 203 F.3d 1305, 1316 (Fed. Cir. 2000).

Claim construction, however, is a question of law reviewed de novo on appeal. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc). Since during prosecution, claims must be given their "broadest reasonable interpretation," this court reviews the Board's interpretation of disputed claim language to determine whether it is "reasonable" in light of all the evidence before the Board. In re Hyatt, 211 F.3d 1367, 1372 (Fed. Cir. 2000); In re Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

Scroggie contends that the Board incorrectly concluded that Angles teaches or suggests limitations defined by claims 41-67. He argues that a hyper-link is not a web page, but rather a logical address which is clearly known on the Internet. With respect to claims 41-49, he asserts that the inclusion of hyper-links in the advertisement sent to the consumer does not generate page data (i.e., result in page data being generated). Consequently, when a consumer clicks on the hyper-link, it does not result in "generating page data defining a web page based upon said personal information data," as recited in claim 41. This is so because the page data, contemplated by the hyper-links in the advertisements disclosed in Angles, already exist in the server computer

having the logical address specified in the hyper-link. Scroggie contends that "[w]hen the user clicks [on] the link in the advertisement, his computer sends a prompt to the corresponding address, and the computer at that address responds with a data file . . . [i.e., a web page], based upon data pre-existing at that computer." (Appellant's Br. 17.) Thus, Scroggie asserts that the Board erred in finding that Angles discloses this limitation because it does not teach or suggest "generating page data defining a web page based upon said personal information data."

The Director of the United States Patent and Trademark Office (the "Director") asserts that Angles teaches selecting custom advertisements to send to a consumer based on a consumer's personal information and that those custom advertisements can contain hyper-links. The Director argues that since the hyper-links are custom-selected and included in the electronic page that shows up on the user's screen, they are "page data." Also, since the hyper-links provide a direct link to a web page, they can reasonably be said to be "page data" that "define a web page" as required by the claims. Additionally, the Director argues that there is no limitation in the claim that prevents the customized page data from "preexisting," rather the only requirement of the claim is that it be customized for that consumer. Thus, when the disclosure in Angles teaches "selecting" customized advertisements which contain hyper-links to other web pages, this is sufficient to teach the "generating page data" element of claims 41-49.

We disagree. The term "generating page data" means that the page data is "generated," not merely "selected." Both the Board and the Director apply an unreasonable construction to the term "generating page data" such that Angles, which teaches "selecting" advertisements which contain hyper-links can somehow teach or

suggest "generating." Generating does not imply a mere selection of pre-existing page data, but rather the creation or origination of such data. Therefore, the Board's construction of "generating page data" was unreasonable and its conclusion that Angles teaches that limitation is thus unsupported by substantial evidence.

Additionally, in regard to independent claim 50, Scroggie argues that although "Angles' advertisement data may depend upon personal information stored at Angles' advertising provider computer. . . . Angles does not show . . . that data stored at some address specified in a hyper-link in an advertisement transmitted to Angles' consumer computer depends upon personal information [sic]." (Appellant's Br. 18.) Thus, Scroggie's argument focuses on the term "personalized web page" as used in claims 50-67.

The Director again argues that Scroggie is improperly reading a limitation into those claims because the term "personalized web page" can reasonably be construed to cover Angles's disclosure of custom-selected web pages which are accessed by clicking on the hyper-links within the advertisements that are sent to the consumer. Thus, the web page is "personalized" because it is custom-selected for the consumer based on personal information provided by the consumer.

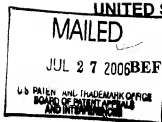
We agree with the Director. The term "personalized web page" as used in claims 50-67 can reasonably be read to cover at least two types of personalization. One type of personalized web page is "personalized" because the contents of the web page transmitted to the consumer are themselves specific to the consumer. Another type of personalized web page is "personalized" because the web page itself, although not necessarily specific to an individual consumer, was chosen to be transmitted, via a

hyper-link, to that consumer based on the consumer's personal data. Because the term "personalized web page" can reasonably be construed to mean either type of "personalized," and because Angles discloses the latter type, Angles teaches this limitation of claims 50-67. Therefore, we will affirm the Board's decision with respect to those claims.

CONCLUSION

Because we find that the Board's construction of the term "generating page data" was unreasonably broad, we find that Angles does not teach or suggest "generating page data" as used in claims 41-49. Additionally, because we find that the Board's construction of the term "personalized" in claims 50-67 was not unreasonable, the Board's finding that Angles teaches or suggests the "personalized web page" limitation in those claims is supported by substantial evidence. Accordingly, we reverse the Board's decision with respect to claims 41-49, and affirm the Board's decision with respect to claims 50-67.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CATALINA MARKETING INTERNATIONAL, INC.

Appeal No. 2006-1585
Reexamination Control No. 90/005,888

ON BRIEF

Before McQUADE, SCHAFER and BARRETT, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

**ORDER DISMISSING THE APPEAL AND REMANDING THE REEXAMINATION
PROCEEDING TO THE EXAMINER**

This appeal involves a reexamination proceeding relating to U.S. Patent No. 6,014,634. The record in the proceeding is in the form of an Image File Wrapper (IFW). The IFW shows that:

- a) on January 30, 2004, an examiner issued a final rejection in which claims 1-39 were found to be patentable and/or confirmed and claims 40-49 were rejected;
- b) on March 30, 2004, the patent owner filed a notice of appeal (the first appeal) to this Board "from the decision dated JANUARY 30, 2004";
- c) on June 30, 2004, the patent owner submitted a brief in furtherance of the first appeal;

d) on May 10, 2005, a different examiner took charge of the proceeding, reopened prosecution and issued a non-final Office action containing various new rejections of claims 1-49;

e) on June 24, 2005, the patent owner filed a "37 CFR 41.31 NOTICE OF APPEAL" (the second appeal) and a "37 CFR 41.39(b)(2) REQUEST TO MAINTAIN THE APPEAL BY FILING A 37 CFR 41.41 REPLY APPEAL BRIEF" (the first reply brief) in response to the non-final Office action;

f) on August 30, 2005, the examiner issued an answer to the first reply brief;

g) on October 3, 2005, the patent owner submitted a "37 CFR 41.41 SECOND REPLY BRIEF" (the second reply brief) in response to the answer; and

h) on January 23, 2006, the examiner issued a paper acknowledging receipt of the second reply brief and forwarded the proceeding to this Board.

As a preliminary matter, we note that at the time the non-final Office action dated May 10, 2005 was mailed, Manual of Patent Examining Procedure (MPEP) §§ 706.07(e), 1002.02(d) and 1208.01 (8th ed., Rev. 2, May 2004) required the approval of a supervisory patent examiner for any new ground of rejection made in an Office action reopening prosecution after the filing of an appeal brief. MPEP § 2275 (8th ed., Rev. 2, May 2004) made it clear that the requirement applied to appeals in patents undergoing ex parte reexamination proceedings.¹ Notwithstanding this directive, the electronic copy of the non-final Office action appearing in the IFW does not show that the new grounds of rejection set forth in the action were approved by a supervisory patent examiner. The lack of supervisory approval was subsequently cured, however, by a decision on petition mailed June 27, 2005. Although the decision on petition dealt with an unrelated matter, it referred twice to the "non-final Office action" over the signature of a Director of Technology Center 3600 and hence implicitly ratified the action and the new grounds of rejection contained therein. Moreover, and in any event, the patent owner did not challenge the

¹ Although the MPEP has since been revised, §§ 706.07(e), 1002.02(d), 1207.04 and 2275 (8th ed., Rev. 4, Oct. 2005), which are currently in effect, carry forward the requirement for supervisory approval in this circumstance.

lack of supervisory approval for the examiner's decision to reopen prosecution and enter the new rejections in the non-final Office action, and thus waived any objection thereto. Consequently, on the record before us, the procedural propriety of the non-final Office action is not at issue.

On appeal, the patent owner seeks review by this Board of the new rejections of claims 1-49 entered in the non-final Office action.

Section 306 of Title 35, United States Code, grants the patent owner in a reexamination proceeding the right to "appeal under the provisions of section 134 of this title." Section 134 reads as follows:

§ 134 Appeal to the Board of Patent Appeals and Interferences

(a) *Patent applicant*.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) *Patent owner*.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.²

(c) *Third-party*.— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

On its face, § 134 does not allow for an appeal to this Board by a patent owner in a reexamination proceeding from anything other than a final rejection. Section 41.31(a)(3) of Title 37, Code of Federal Regulations, mirrors the statute by providing in pertinent part that "[e]very owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally

² This provision applies to reexamination proceedings filed on or after November 29, 1999. See MPEP § 2273 (8th ed., Rev. 4, Oct. 2005)). The instant reexamination proceeding was filed December 12, 2000.

(§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board.” MPEP § 2273 (8th ed., Rev. 4, Oct. 2005)) goes somewhat further in stating that “[i]n an *ex parte* reexamination filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of the claims.”

By reopening prosecution in the non-final Office action, the examiner in effect withdrew the finality of the Office action mailed January 30, 2004. Therefore, at the present time claims 1-49 are not under final rejection. The record indicates that the patent owner was well aware of this fact and the problems it might pose in pursuing an appeal at this juncture of the reexamination proceeding. For example, in the second notice of appeal filed June 24, 2005, the patent owner pointedly left blank the space provided for insertion of the date of the “final office action” being appealed, signifying an awareness that the Office action being appealed was not a final rejection. In contrast, the first notice of appeal filed March 30, 2004 specified the January 30, 2004 date of the final rejection (since withdrawn) being appealed. Furthermore, the curious submission of the request that the appeal, i.e., the first appeal, be maintained and the first reply brief suggests that the patent owner appreciated the questionable nature of an appeal from a non-final Office action.

At this point, we would note that in the non-final Office action (see page 2) the examiner, citing 37 CFR § 1.193(b)(2), directed the patent owner to respond by filing either a reply under 37 CFR § 1.111 or a request for reinstatement of the appeal and a supplemental brief. This instruction was erroneous because 37 CFR § 1.193 previously had been withdrawn in its entirety effective September 13, 2004. See 69 FR 49960, 50000, August 12, 2004; and 1286 OG 21, 54, September 7, 2004. The patent owner, in apparent recognition of the examiner’s error, instead chose to file the unorthodox

combination of (1) a request that the first appeal be maintained with an accompanying reply brief pursuant to 37 CFR § 41.39(b)(2), and (2) a second appeal pursuant to 37 CFR § 41.31.

The patent owner's reliance on § 41.39(b)(2) as authority for requesting that the first appeal be maintained is untenable. Such provision pertains solely to responses to new grounds of rejection in an examiner's answer. To justify the request, the patent owner urged that the non-final Office action "although styled as an office action, was in fact in response to the appeal brief originally filed in the USPTO June 30, 2004 . . . [i]n other words, the paper mailed by the USPTO May 10, 2005 was an examiners' answer" (second reply brief, page 2). Clearly, however, the non-final Office action was not an examiner's answer in either styling or substance.

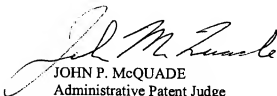
The reopening of prosecution by the examiner in the non-final Office action removed the basis for the first appeal mandated by statute, i.e., the final rejection mailed January 30, 2004, and thus rendered the first appeal moot. The patent owner's request to maintain such appeal has no basis in law or reason. That the examiner tacitly approved the patent owner's submissions by mailing an answer to the first reply brief, acknowledging receipt of the second reply brief and forwarding the proceeding to the Board is of no moment. Once prosecution was reopened in the non-final Office action, the first appeal stood terminated.

The second appeal filed pursuant to 37 CFR § 41.31 in response to the non-final Office action did not solve the patent owner's plight. The pertinent portion of § 41.31(a)(3) reproduced above, which echoes 35 U.S.C. § 134(b), does not support, and

in fact belies, any notion that the patent owner had a right to appeal to this Board from the non-final Office action.

We are therefore constrained to conclude that this Board lacks jurisdiction under 35 U.S.C. § 134(b) to hear the patent owner's appeal, essentially because claims 1-49 are not under final rejection. Accordingly, the appeal is dismissed and the reexamination proceeding is remanded to the examiner for further action consistent with USPTO practice.

DISMISSED and REMANDED


JOHN P. McQUADE
Administrative Patent Judge


RICHARD E. SCHAFER
Administrative Patent Judge


LEE E. BARRETT
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
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Appeal No. 2006-1585
Reexamination Control No. 90/005,888

7

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA, VA 22304

NEIFELD DOCKET NO: CAT29US-SCRCO3

Printed: October 17, 2006 (4:02pm)

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Brief_061016.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Scroggie et al.

Appeal No. 2008-4478
Application No. 09/401,939

Mailed: July 18, 2008

DECISION ON PETITIONS

This is a decision on the following petitions:

“37 CFR 1.81 Petition to Withdraw the Notification of Non-compliant Appeal Brief Dated March 31, 2008,” filed April 9, 2008 (“First Petition”); and

“37 CFR 1.81 Petition to Withdraw the Notification of Non-compliant Appeal Brief Dated April 21, 2008,” filed May 20, 2008 (“Second Petition”).

These petitions will be treated as petitions to the Chief Administrative Patent Judge under 37 C.F.R. § 41.3(b).

FINDINGS

1. On August 10, 2006, Appellants filed an original Appeal Brief (“Original Brief”) citing and quoting, in the arguments section, a dictionary definition of the term “voucher.” App. Br. at 15.
2. On November 29, 2007, the Board of Patent Appeals and Interferences (“Board”) entered an Order stating:

The dictionary [definition of voucher] should be included along with a copy of said term in the Evidence Section of the Appeal Brief. *See* MPEP Section 1205.02.

Order at 2. The Order also ordered that the application be returned to the Examiner for the Examiner “to instruct Appellants to file a Paper adding the abovementioned reference to the [E]vidence Appendix.” *Id.* at 3.

3. On March 31, 2008, the Examiner entered a Notification of Non-compliant Appeal Brief advising Appellants that the Original Brief was defective and specifically that the term “voucher” and related dictionary definition should be added to the evidence appendix of the Original Brief.
4. 37 C.F.R. § 41.37(c)(1)(ix), which sets forth the types of evidence that must be presented in the evidence appendix of an appeal brief, does not identify dictionary definitions as a type of evidence that must be presented in the evidence appendix for such definitions to be considered by the Board in an *ex parte* appeal.
5. On April 9, 2008, Appellants filed a “37 CFR 41.37 Replacement Appeal Brief” (“First Replacement Brief”), in which the citation to a dictionary was removed from the body of the brief (p. 15).
6. As indicated above, on April 9, 2008, Appellants also filed the First Petition, requesting, *inter alia*, that the Notification of Non-compliant

Appeal Brief be withdrawn as to the Original Brief and that such brief be reinstated

7. On April 21, 2008, the Patent Appeal Center Specialist entered a Notification of Non-Compliant Appeal Brief advising Appellants that the First Replacement Brief was defective and specifically that the Status of Claims and Summary of Claimed Subject Matter sections were deficient.
8. The Status of Claims and Summary of Claimed Subject Matter sections of the First Replacement Brief are identical to those sections of the Original Brief.
9. On May 20, 2008, Appellants filed a “37 CFR 41.37 Second Replacement Appeal Brief” (“Second Replacement Brief”), including modifications to the Status of Claims and Summary of Claimed Subject Matter sections of the Second Replacement Brief as compared to those sections of the Original and First Replacement Briefs. The modifications made to the Status of Claims and Summary of Claimed Subject Matter sections of the Second Replacement Brief corrected defects in those sections of the Original and First Replacement Briefs.
10. As indicated above, on May 20, 2008, Appellants also filed the Second Petition requesting, *inter alia*, that the Notification of Non-compliant Appeal Brief be withdrawn as to the First Replacement Brief and that the Original Brief be reinstated.
11. Based on Appellants’ submission of the Second Replacement Brief, on July 16, 2008, the appeal for this application was docketed as Appeal No. 2008-4478.

DISCUSSION

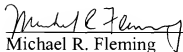
The Original and First Replacement Briefs both contained defective Status of Claims and Summary of Claimed Subject Matter sections. Those defects were corrected in the Second Replacement Brief. Thus, the filing of the Second Replacement Brief renders moot any alleged or actual defects in the Original and First Replacement Briefs.

DECISION

In view of the foregoing, the First and Second Petitions are DISMISSED as moot. The appeal process will proceed with Appellants' position being presented by the Second Replacement Brief and the Reply Brief, filed April 6, 2007, and the Examiner's position being presented by the Examiner's Answer, entered February 27, 2007.

The merits panel to which this appeal is assigned for decision is authorized to consider, to the extent it may be relevant, Appellants' statement in the Original Brief, p.15, that:

A voucher means "a document that provides supporting evidence for a claim, e.g. a receipt proving that a purchase was made." See for example:
<http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861732375>.



Michael R. Fleming
Chief Administrative Patent Judge

Appeal No. 2008-4478

Application No. 09/401,939

Richard A. Neifeld

Neifeld IP Law, PC

4813-B Eisenhower Avenue

Alexandria, VA 22304

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2008-1491
(Re-examination No. 90/005,888)

IN RE CATALINA MARKETING CORPORATION

Appeal from the United States Patent and Trademark Office, Board of
Patent Appeals and Interferences.

ORDER

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

2008-1491
(Re-examination No. 90/005,888)

IN RE CATALINA MARKETING CORPORATION

Appeal from the United States Patent and Trademark Office, Board of
Patent Appeals and Interferences.

ON MOTION

ORDER

Upon consideration of the motion to withdraw this appeal,

IT IS ORDERED THAT:

- (1) The motion is granted. The appeal is dismissed.
- (2) Each side shall bear its own costs.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUL 29 2008

JAN HORBALY
CLERK

FOR THE COURT



Jan Horbaly
Clerk

JUL 29 2008

Date

cc: United States Patent and Trademark Office
Richard A. Neifeld, Esq.
Stephen Walsh, Esq.

ISSUED AS A MANDATE: July 29, 2008

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NOTICE OF DOCKETING

2008-1491 – IN RE CATALINA MARKETING

Date of docketing: 07/29/2008

Appeal from: Patent and Trademark Office – Board of Patent Appeals & Interferences in
Reexamination no. 90/005,888

Appellant: Catalina Marketing Corporation

Critical dates include:

- Date of docketing. See Fed. Cir. R. 12 and 15.
- Entry of appearance. See Fed. Cir. R. 47.3.
- Certificate of interest. See Fed. Cir. R. 47.4.
- Docketing Statement. (*Due within 14 days of the date of docketing, or within 30 days if the United States or its officer or agency is a party in the appeal.*) See the en banc order dated September 18, 2006. [Counsel can download a copy of the order and guidelines at www.cafc.uscourts.gov.]
- Requests for extensions of time. See Fed. Cir. R. 26 and 27. **N.B. Delayed requests are not favored by the court.**
- Briefs. See Fed. Cir. R. 31. **N.B. You will not receive a separate briefing schedule from the Clerk's Office.**
- Settlement discussions. See Fed. Cir. R. 33.
- Oral argument schedule conflicts. See Practice Note following Fed. Cir. R. 34.

Pro se parties should refer to the [Guide for Pro Se Petitioners and Appellants](#).

Attachments:

- Official caption to all.
- Docketing Statement. (Only in cases where all parties are represented by counsel.)
- Rules of Practice to pro se parties. [Counsel can download the rules from www.cafc.uscourts.gov or call 202.633.6550.]
- Entry of appearance form to all.
- Informal brief form to pro se parties.
- Motion and Affidavit for Leave to Proceed in Forma Pauperis form to appellants owing the docketing fee.

Jan Horbaly
Clerk

cc: Office of the Solicitor, US Patent and Trademark Office
Stephen Walsh
Richard A. Neifeld

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Official Caption¹

2008-1491
(Re-examination No. 90/005,888)

IN RE CATALINA MARKETING CORPORATION

Appeal from the United States Patent and Trademark Office, Board of
Patent Appeals and Interferences.

Authorized Abbreviated Caption²

IN RE CATALINA MARKETING, 2008-1491

¹ Required for use on petitions, formal briefs and appendices, court opinions, and court orders.
FRAP 12(a); 32(a).

² Authorized for use only on items not requiring the Official Caption as listed in note 1.

2008-1491

United States Court of Appeals for the Federal Circuit

Catalina Marketing Corporation, Appellant

v. NOTICE OF APPEAL

Jon W. Dudas, Appellee.
in his official capacity as
Director of the United States
Patent and Trademark Office,

Catalina Marketing Corporation hereby appeals to the Court for review of the Decision on Appeal before the Board of Patent Appeals and Interferences in Appeal No. 2007-2809 in Reexamination Control No. 90/005,888, Patent No. 6,014,634, decided on April 23, 2008.

Three copies of this notice and a check for docketing the appeal, for \$450, is concurrently being sent to the Court.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JUL 29 2008

IAN HORBALY
CLERK

6/18/2008

Date

/RichardNeifeld#35,299/

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Printed: June 18, 2008 (12:04pm)